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IN THE

Supreme Court of the United States

PLANET BINGO, LLC AND GARY WEINGARDT,
Petitioners,

v.

GAMETECH INTERNATIONAL, INC., RICHARD FEDOR, GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition For Writ Of Certiorari To The United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Can the Federal Circuit's expanding "vitiation" doctrine, which is based on a misapplication of a teaching in a footnote in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), be applied as a matter of law to bar a claim of infringement under the doctrine of equivalents, when the evidence of record shows that the accused infringing element is only insubstantially different from that which is claimed?

2. Is the determination of patent infringement under the doctrine of equivalents an issue for the court or the jury to decide – a question specifically left open in *Warner-Jenkinson*?

PARTIES TO THE PROCEEDINGS AND RULE 29.6 STATEMENT

Petitioners in this case are Planet Bingo, LLC ("Planet Bingo") and Gary Weingardt. Planet Bingo has no parent corporation, and no publicly held company owns 10 percent or more of its stock.

Respondents are GameTech International, Inc., Richard Fedor, Gary Held, and Graham Leonard.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners Planet Bingo, LLC and Gary Weingardt respectfully seek a writ of certiorari to the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Federal Circuit (App. 05-1476) was entered on December 13, 2006 and is reported at 472 F.3d 1338 (Fed. Cir. 2006). App. 1a.[1] The Order denying the Petition for Panel Rehearing and Rehearing en Banc (App. 05-1476) was entered on January 22, 2007 and is unreported. App 17a. The opinion of the United States District Court for the District of Nevada (Case No. 01-CV-1295), granting summary judgment of non-infringement, was entered on May 25, 2005, and is unreported. App 38a.

JURISDICTION

The court of appeals entered its judgment in this case on December 13, 2006 and denied the Petition for Panel Rehearing and Rehearing en Banc on January 22, 2007. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

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1 Citations to "App." are to the appendix to this petition. Citations to "C.A.A." are to the joint appendix filed in the Court of Appeals.

STATUTORY PROVISION INVOLVED

35 U.S.C. § 271 provides in pertinent part:

§ 271. Infringement of Patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

INTRODUCTION

Seizing on a single word in a footnote in this Court's landmark *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.* decision, the Federal Circuit has carved out a steadily widening exception to the doctrine of equivalents. That doctrine permits recovery by a patent holder, even where there is no literal infringement of a patent, where there are only "insubstantial" differences between that which is claimed and the accused product/process. This Court reaffirmed the doctrine of equivalents both in *Warner-Jenkinson* and more recently in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002). The Supreme Court, has emphasized, time and again, the importance of the doctrine in protecting the value of patents and thereby incentivizing the continued innovation that is central to the nation's economy.

In *Warner-Jenkinson*, the Court provided an important analytical framework to the analysis of infringement under the doctrine of equivalents. Specifically, it held that the doctrine of equivalents must be analyzed on an element by element basis, rather than through a

comparison between the accused product/process and the claim as a whole. Under this approach, a finding of infringement under the doctrine of equivalents requires that every single claimed element be present in the accused product/process, either literally or equivalently. Consistent with that holding, the Court stated in a footnote that an application of the doctrine that would ignore, or entirely "vitiate" a claim element, is not permitted.

Since the handing down of this landmark decision in 1997, the Federal Circuit has crafted a steadily expanding "vitiation" doctrine, based on the *Warner-Jenkinson* footnote. The Federal Circuit's rule, in contrast to the clear teachings of *Warner-Jenkinson*, is *not* concerned with preventing a finding of infringement under the doctrine of equivalents where a particular claim element is simply not found – whether literally or equivalently – in the accused product/process.

Instead, the Federal Circuit has used an ill-defined and inconsistently applied linguistic test, which takes from the jury the issue of infringement under the doctrine of equivalents for a steadily-expanding group of claims. If a claim term or a court-supplied interpretation of that claim term includes a word that has an antonym, if it includes a chemical range, if it recites a structure with an undetermined amount of specificity, or if there is a timing limitation, the claim is vulnerable to a judicial interpretation that a finding of infringement under the doctrine of equivalents would "vitiate" that term. As applied by the Federal Circuit, the vitiation doctrine permits such a finding in the face of evidence that the accused product/process in fact contains the substantial equivalent of the claimed element – and without *any* finding of prosecution history estoppel that would justify depriving the patentee of its equivalence claim.

The Federal Circuit's approach clearly flouts the basic teachings of *Warner-Jenkinson* and *Festo*.

The folly of the Federal Circuit's "vitiation" doctrine is shown in stark relief in this case. Here, the claim element at issue concerned the establishment of a "predetermined winning combination" for a bingo game. The district court found that the accused game had "predetermined aspects," and the Federal Circuit went one step further and stated that "Rainbow Bingo certainly contains a 'progressive . . . predetermined winning combination.'" Nevertheless, through the vitiation doctrine, the Federal Circuit affirmed a finding that, as a matter of law, there could be no showing of infringement under the doctrine of equivalents for this claim element.

As this Court held in *Festo*: "The patent laws 'promote the Progress of Science and useful Arts' by rewarding innovation with a temporary monopoly. The monopoly is a property right, and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation." 535 U.S. at 730-731. Adherence to established rules regarding the scope and enforceability of patents is therefore of considerable national importance. Recognizing this, the Supreme Court took up the doctrine of equivalents in both the *Warner-Jenkinson* and *Festo* cases. The granting of *certiorari* here is necessary to ensure that this Court's rulings, and in particular the element-by-element test of *Warner-Jenkinson* and prosecution history estoppel as limited by *Festo* – are being faithfully applied by the lower courts, so that patent value is preserved and innovation incentivized.

STATEMENT OF THE CASE

A. The Game of Bingo

Bingo play is an old and well-known game of chance. In a typical prior art game of bingo, players purchase one or more paper cards. These cards are organized into a five-by-five matrix consisting of five columns labeled "B", "I", "N", "G" and "O" and five rows. A bingo card contains twenty-four numbered spaces.2

The classic American bingo game also utilizes a ball hopper containing 75 numbered balls. The numbers on the balls correspond to the numbered spaces on the card. For example, ball number "6" or "B6" would correspond to a numbered space in the "B" column having the number 6 inside.

In the most basic form of bingo, the game operator announces a winning combination and the jackpot. Often, the combination is a particular combination of numbered spaces. A common example is a straight line bingo (i.e., filling a single bingo column or row).

The bingo operator then draws balls from the hopper one at a time, calling the letter and number of each ball as it is drawn. As each ball is called, the players "daub" the corresponding space, if any, on their card(s). Classically, daubing involved placing a chip or other item on the space, or marking the space with an ink marker. In recent years, electronic bingo machines have been introduced, which permit players to play multiple electronic bingo cards and to electronically daub their card(s).

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2 The middle space in the "N" column is typically labeled as a "free space."

In traditional bingo, play continues until the first player(s) achieved the winning combination for the particular game. The player(s) with the winning combination would then call out "Bingo." With the calling of "Bingo," the game ends. C.A.A. 812-14, ¶¶ 5-10.

B. The '289 and '786 Patents

The '289 and '786 Patents created new possibilities for bingo play by introducing the concept of associating bingo numbers with "indicia" or "markings," such as different colors. *See* C.A.A. 105, Col. 5:27-29; C.A.A. 119, Col. 3:48-52. Thus, in addition to the jackpot for achieving a bingo combination in the traditional manner – such as a straight line bingo in the "B" column of the card – these patents disclosed the concept of a separate jackpot for a bingo combination where all of the numbers in the straight line bingo combination were associated with particular "markings" (e.g., an all white bingo, an all red bingo, an all red with black stripes bingo, or a mixed bingo). See, *e.g.*, C.A.A. 105, Col. 5:27-29; C.A.A. 120, Col. 5:39-55. Moreover, these additional jackpots could be made "progressive" (i.e., rolling over from game to game until won), bringing large jackpots into the world of bingo. See, *e.g.*, C.A.A. 119, Col. 3:4-9. 3

The '786 Patent is a Continuation-in-Part of the '289 Patent, and the claim term that was central to the district court's and Federal Circuit's rulings is found in the claims of both patents. The term "predetermined winning combination" for the "progressive" jackpot appears in one form or another in all claims that were at issue below. More particularly, all claims recite, in one form or another, the method step of "establishing" a "predetermined winning combination" for a

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3 The jackpot for the multi-state lottery known as the Powerball® is an example of a progressive jackpot.

"progressive" jackpot. See, *e.g.*, C.A.A. 123-24, Cols. 12-13 (emphasis supplied).

As discussed in detail below, the critical infringement issue for purposes of this petition relates to *when* the step of "establishing" the predetermined winning combination for the progressive jackpot must occur.

C. Planet Bingo's MP Bingo Game

Planet Bingo has commercialized the bingo game that is described in the '289 and '786 Patents. The game that it developed is called "MPBingo." In MP Bingo, each of the 75 bingo numbers is assigned one of five different colors, and there are five progressive jackpots associated with the five colors. C.A.A. 814-15, ¶¶11-12. A player wins an MP Bingo progressive jackpot by achieving a straight line bingo in which all of the numbers in the winning combination are a single color.

D. GameTech's Rainbow Bingo Game

Shortly before Planet Bingo filed suit, GameTech began offering for sale a progressive bingo game called "Rainbow Bingo." Rainbow Bingo utilized the assignment of "indicia" (including colors and jewel and coin symbols), to create progressive bingo jackpots.

GameTech developed its Rainbow Bingo progressive bingo game to compete with Planet Bingo's MPBingo game. See, *e.g.*, C.A.A. 1589. Referring to Planet Bingo, GameTech told its employees that: "We need to stop this cancer before it spreads." C.A.A. 2730. It trained its salesmen on "How to Sell Against Planet Bingo." C.A.A. 2130:21-2132:3. During development, Rainbow Bingo co-inventor Calvin Nicholson visited the Planet Bingo web-site

to look at MPBingo. C.A.A. 1619. At that site, Planet Bingo advertised to potential customers the availability of a video about MPBingo. Mr. Nicholson ordered the video, using his home e-mail address so as to conceal from Planet Bingo the true destination for that tape. *Id.* GameTech was aware of the '289 and '786 Patents during development. *Id.*

Like MPBingo and the games claimed in the '289 and '786 Patents, Rainbow Bingo utilizes a traditional five-by-five bingo card, and there is a basic winning pattern that will always include a straight line. C.A.A. 791, C.A.A. 795. Also like MPBingo and the claimed games, Rainbow Bingo uses colors (e.g., blue and purple) and other designations (e.g., rubies, emeralds and diamonds) for certain game spaces to create progressive winning combinations. More specifically, every game of Rainbow Bingo includes multiple progressive predetermined combinations, including three blue column progressives, one purple column progressive, two ruby row progressives, and three emerald row progressives. These combinations require a straight line bingo in a particular row or column.

In a rough attempt to take itself just outside the line of infringement of the '289 or '786 Patents, GameTech added to the 2002 version of Rainbow Bingo the gimmick of calling one ball before locking in the indicia designations to specific rows and columns, according to pre-defined rules. C.A.A. 2067:7-2068:23.4 GameTech documents do not provide any explanation for the one ball feature, and one of its developers admitted that its actual purpose is to support a non-infringement argument with respect to the '289 and '786 Patents. C.A.A. 2067:7-2068:22. Indeed, GameTech's own

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4 It is telling that GameTech's own patent filings – made *after* the filing of this lawsuit – characterize its winning combinations as "predetermined" (and also as "pre-defined"), the very word used in the claims at issue. C.A.A. 725, ¶ 18; C.A.A. 1379, ¶ 44.

expert admitted that players do not care which particular rows and columns receive the designations. C.A.A. 2372:14-2373:6; C.A.A. 2377:23-2378:7. Planet Bingo's bingo expert opined that, in fact, there is no bingo significance to GameTech's one-ball feature. C.A.A. 818-19, ¶¶ 20-21.

E. District Court Proceedings

The district court delegated claim interpretation to Magistrate Peggy Leen. The claim terms that Magistrate Leen was asked to consider included "establishing a predetermined winning combination" for a "progressive jackpot."

Approximately nine months after oral argument, the Magistrate issued a Markman order, adopting all of GameTech's proffered interpretations without any comment or analysis. C.A.A. 1-16. In relevant part, the interpretation of "establishing a predetermined winning combination" for a "progressive jackpot" included the following language proposed by GameTech: "[t]he precise elements necessary to achieve a 'bingo' in a particular bingo game determined before the first bingo ball is drawn." C.A.A. 13. None of the critical language in this definition – i.e., "precise elements" or "before the first bingo ball is drawn" – is found in the claims, specification or prosecution history of either patent.

After the Markman ruling, GameTech moved for summary judgment of non-infringement.5 The district court

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5 Because the pre-trial motions deadline had passed – and, indeed, prior GameTech motions for summary judgment of non-infringement had early been denied – GameTech styled its request for judgment in its favor based on a non-infringement theory as a *motion in limine*.

granted GameTech's motion, holding that Planet Bingo's infringement allegations as to all but two of the claims in the '289 and '786 Patents were barred as a matter of law. App. 17a.6 In reaching this conclusion, the district court focused on the "predetermined winning combination" element. Specifically, the district court held that "[a]lthough Rainbow Bingo players would know *some predetermined aspects* before the start of a Rainbow Bingo game, players will not know the 'combination of one or more spaces on a bingo card matrix which, when covered by a player represent a bingo win." App. 29a-30a. In this regard, the district court reasoned that "Rainbow Bingo players would not know until after the first ball which columns specifically have been designated as blue, purple, pink or orange; what numbers are diamond numbers; or which rows are ruby, emerald, silver or gold." App. 30a. Accordingly, the district court found as a matter of law that this claim element was not literally infringed. *Id.*

The district court next considered the issue of infringement under the doctrine of equivalents. It acknowledged that there was only a "*slight difference in timing*" between establishing the progressive winning combination "before and after the first ball is drawn." App. 34a-35a (emphasis supplied). It acknowledged further that under one line of Federal Circuit cases, this would be sufficient to raise an issue of material fact, precluding summary judgment of non-infringement. *Id.* However, the court held that such a finding was barred as a matter of law because it would "vitiate" the claim language. According to the court: "After is the opposite of before, not its equivalent." App. 35a. The court therefore also entered

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6 In response to a second GameTech motion, the Court ruled that the remaining two claims were invalid. That ruling is not the subject of this petition.

summary judgment of no infringement under the doctrine of equivalents. App. 36a.

F. Federal Circuit Proceedings

On appeal, the Federal Circuit affirmed all aspects of the district court's summary judgment of non-infringement. With respect to literal infringement, the court conceded that "Rainbow Bingo certainly contains a `progressive . . . predetermined winning combination,' indeed it would be impossible to play without one." App. 9a. However, according to the court, "Rainbow Bingo does not disclose to a player the predetermined winning combination until after the game is underway." App. 10a. It therefore affirmed the finding of no literal infringement.

With respect to infringement under the doctrine of equivalents, the court held that application of the doctrine to this case "would change `before' to `after.'" App. 12a. It noted that the Federal Circuit "has refused to apply the doctrine [of equivalents] in other cases where the accused device contained the antithesis of the claimed structure." App. 12a-13a. Accordingly, it also affirmed summary judgment of non-infringement under the doctrine of equivalents.

Planet Bingo sought rehearing from the Federal Circuit, focusing on its disposition of the issue of infringement under the doctrine of equivalents. In its petition, it asserted that a finding of no-infringement under the doctrine of equivalents, as a matter of law, is appropriate only where no reasonable jury could have found the differences between the claimed and accused elements to be "insubstantial." Because the district court expressly found that there was only a "slight difference in timing" between the claimed method and Rainbow Bingo, no such finding

could have been made here and the issue should have gone to the jury. On January 22, 2007, the Federal Circuit denied the petition for rehearing without opinion. App. 38a.

REASONS FOR GRANTING THE PETITION

1. The Federal Circuit's "Vitiation Doctrine" Represents a Departure from this Court's Fundamental Teachings Regarding Infringement Under the Doctrine of Equivalents

a. The Doctrine of Equivalence and the Supreme Court's Consistent Emphasis on the Concept of "Insubstantial" Differences

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950), this Court established the modern contours of the doctrine of equivalents. Under that doctrine, an accused product or process that does not literally infringe a patent claim may nevertheless be found to infringe if there is "equivalence" between the claimed element and the accused product or process.

Over at least the last century and a half, this Court's decisions have consistently reflected that the touchstone of a finding of equivalence is the requirement that the differences between the accused and claimed element be "insubstantial." *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002) (if patents were only given literal enforcement, "[u]nimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying"); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40, 117 S.Ct. 1040, 137

L.Ed.2d 146 (1997) ("An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element."); *Graver Tank*, 339 U.S. at 607 (patent claims must protect against those who "make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law"); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 343, 14 L.Ed. 717 (1854) ("the exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it, varying its form or proportions").

In 1997, this Court reaffirmed the continued vitality of the doctrine of equivalents, holding that it had survived the 1952 revision of the Patent Act. *Warner-Jenkinson*, 520 U.S. at 26-27. The *Warner-Jenkinson* decision also introduced an important clarification, holding that the doctrine of equivalents "must be applied to individual elements of the claim, not to the invention as a whole." 520 U.S. at 29. With respect to the requirement of an element by element determination, the Court cautioned that application of the doctrine not be "allowed such broad play as to effectively eliminate that element in its entirety." Id.

The *Warner-Jenkinson* Court discussed "the concern over unreviewability due to black-box jury verdicts" regarding equivalence. 520 U.S. at 39 n. 8. It held that "[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." *Id.* It continued: "Thus, under the particular facts of a case, if prosecution history estoppel would apply or if a theory of

equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further *material* issue for the jury to resolve." *Id.* (emphasis in original).

b. The Federal Circuit's Creation of a "Vitiation" Doctrine, Based on a Misreading of *Warner-Jenkinson*

The discussion in footnote 8 of *Warner-Jenkinson*, admonishing courts to guard against a theory of equivalence that would "vitiate" a claim element, has given rise to a "vitiation doctrine" and a confusing and irreconcilable jurisprudence in the Federal Circuit. The vitiation doctrine takes a rigid, linguistic approach in which the judge determines whether a claim term in the element for which equivalence is alleged has an antonym, or is otherwise particularly specific. If it meets this ill-defined language test, no range of equivalence will be available for that claim – without any regard to the substantiality of the differences between the claimed and accused elements.

Moore U.S.A., Inc. v. Standard Register Co., 229 F.3d 1091 (Fed. Cir. 2000) is exemplary. The *Moore* case concerned an infringement claim related to a "mailer." The claim at issue recited the element of "first and second longitudinal strips of adhesive" positioned on "longitudinal marginal portions" of the mailer, and further stated that the strips "extend[ed] the *majority* of the lengths of" the longitudinal marginal portions. 229 F.3d at 1095 (emphasis supplied). In the accused infringing product, the adhesive strips extended "about 48% of the length of the longitudinal margins." *Id.* at 1106. The plaintiff contended that the longitudinal strips of the accused mailer were the equivalent of the claimed strips.

The district court granted summary judgment of non-infringement under the doctrine of equivalents. Over a dissent by Judge Newman, the Federal Circuit affirmed, rejecting the plaintiff's theory of equivalence as a matter of law. It held that "applicant's use of the term `majority' is not entitled to a scope of equivalents covering a minority." 229 F.3d at 1106. According to the court: "[T]o allow what is undisputedly a minority (i.e., 47.8%) to be equivalent to a majority would vitiate the requirement that the `first and second longitudinal strips of adhesive . . . extend the majority of the lengths of said longitudinal marginal portions.'" *Id.* The Federal Circuit reasoned that "it would defy logic to conclude that a minority – the very antithesis of a majority - could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise." *Id.*

Judge Newman dissented in part from the court's decision. She characterized the majority's ruling as "negat[ing] equivalency as a matter of law as between substantially identical elements having slight numerical differences" and therefore as "not in accordance with precedent." 229 F.3d at 1119. Judge Newman would have treated as a "question of fact" the issue of "[w]hether 47.8% is equivalent to a majority." *Id.*

In a growing line of cases, the Federal Circuit has applied the same linguistic approach to find particular assertions of the doctrine of equivalence barred based on the vitiation doctrine. See, *e.g.*, *Asyst Technologies,Inc. v. Emtrak, Inc.*, 402 F.3d 1188, (Fed. Cir. 2005) (an unmounted microcomputer could not be the equivalent of a mounted one "without vitiating the `mounted on' limitation altogether); *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317, 1320, 1322 (Fed. Cir. 2002) (a "workover port extending laterally through the wall of the spool tree

from *between the two plugs*" could not be infringed by an accused device having a workover port connected "*above the two plugs*"); *Tronzo v. Biomet*, 156 F.3d 1154, 1160 (Fed. Cir. 1998) (holding that claim directed to a cup having "a generally conical outer surface" could not, as a matter of law, be infringed by a "hemispherical cup.")

Increasingly, the "vitiation" doctrine is being asserted in pharmaceutical cases – including two times in the first month following the issuance of the Federal Circuit's decision in this case. See, *e.g.*, *Ortho-McNeil Pharmaceutical, Inc. v. Caraco Pharmaceutical Laboratories, Ltd.*, 476 F.3d 1321 (Fed. Cir. 2007); *Abbott Laboratories v. Andrx Pharmaceuticals, Inc.*, 473 F.3d 1196 (Fed. Cir. 2007); *Pfizer, Inc. v. Teva Pharmaceuticals, USA, Inc.*, 429 F.3d 1364 (Fed. Cir. 2005); *Tap Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, L.L.C.*, 419 F.3d 1346 (Fed. Cir. 2005); *Novartis Pharmaceuticals Corp. v. Eon Labs. Mfg., Inc.*, 363 F.3d 1306 (Fed. Cir. 2004). The *Ortho-McNeil* case particularly highlights the conflict between *Warner-Jenkinson* and the vitiation doctrine.

In *Ortho-McNeil*, the plaintiff alleged infringement of a patented composition for a pain reliever. One claim term recited a weight ratio of tramadol to acetaminophen of "about 1:5." The district court interpreted this term to mean a ratio of "no greater than 1:3.6 to 1:7.1." 476 F.3d at 1328. The accused infringing product had a weight ratio of 1:7.5. The district court entered summary judgment of no infringement under the doctrine of equivalents, holding that application of the doctrine on these facts would "vitiate" the "about 1:5" limitation. *Id.* The Federal Circuit affirmed, holding that "an infringement analysis that stretches the bounds of the 'about 1:5' limitation" beyond certain "confidence levels" expressed in the specification would "directly conflict[] with the patent's express claim to . . . the

. . . 1:5 ratio[]." *Id.*; ***but see Abbott Laboratories v. Dey, L.P.***, 287 F.3d 1097 (Fed. Cir. 2002).

The Federal Circuit's treatment of the range in *Ortho-McNeill* as a limitation that compels application of the "vitiation" doctrine is in flagrant disregard of this Court's holding in *Warner-Jenkinson*. There, this Court held that the plaintiff could assert infringement, based on the doctrine of equivalents, of a claim directed to a purification process occurring "at a pH from approximately 6.0 to 9.0" – where the defendant's process operated at a pH of 5.0. 520 U.S. at 1045-1046. *Ortho-McNeill* provides clear evidence that the Federal Circuit's "vitiation" doctrine is inconsistent with this Court's repeated emphasis of the need to focus on whether differences are "substantial."

Other Federal Circuit decisions – including one issued less than a month before the ruling in this case – have rejected assertions of the vitiation doctrine in favor of an approach that focuses on the "substantiality" of differences. See, *e.g.*, *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1019-1020 (Fed. Cir. 2006); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 850 (Fed. Cir. 2006); *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369, 1375 (Fed. Cir. 2003); *Optical Disc Corporation v. Del Mar Avionics*, 208 F.3d 1324, 1336-1337 (Fed. Cir. 2000).

The *Ericsson* case is particularly instructive. There, the court considered an assertion of infringement under the doctrine of equivalents for a claim element having the requirement that "speech signal amplifiers, which require power, *only* supply power to the telephone set when the receiver is off its cradle and a call can be made." 352 F.3d at 1374 (emphasis in original). In the accused device, power was supplied when the receiver was on its cradle .1% of the time. *Id.* at 1375. According to the Federal Circuit: "Such a

trivial difference does not vitiate the 'only supply power' limitation because . . . the speech signal amplifiers in the accused devices are very close to only supplying power to the telephone set when the receiver is in the off-hook position." *Id.* Of course, a "trivial" difference was sufficient to defeat the doctrine of equivalents based on vitiation in *Moore*, *supra*, and here.

There is currently no reliable basis for ascertaining whether a particular claim term will support application of the Federal Circuit's "vitiation" doctrine. There are cases, including those relied upon by the panel in this case, where narrowing structural language in the claims has been found to support a finding, as a matter of law, that a particular theory of equivalence would "vitiate" a claim limitation. This has created an implication that the key to application of the vitiation doctrine is the presence of narrowing structural language. *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) ("Because this patent contains *clear structural limitations*, the public has a right to rely on those limits in conducting its business activities.") On the other hand, there are multiple cases where narrowing structural language has been found to *not* warrant a finding of vitiation. In contrast to *Sage*, one panel has held that the vitiation doctrine will *not* automatically apply where "a claim limitation describ[es] a specific shape of a claimed structure." *Optical Disc Corp.*, 208 F.3d at 1337.

Timing limitations – such as the one found to be present in the claims in this case – have also led to disparate outcomes. While the panel below barred the use of the doctrine of equivalents with respect to a claim term that was found to dictate *when* a winning combination was established, a number of prior cases have declined to apply the vitiation doctrine, despite the presence in the claim of a clear temporal limitation. See, *e.g.*, *Ericsson, Inc. v. Harris*

Corp., *supra*; *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1321 (Fed. Cir. 1998) (holding that doctrine of equivalents could be asserted for a feature of "a restraining structure separate from said pusher bar for blocking said barrier assemblage to maintain said resilient projecting member out of the path of the pusher assembly *during staple firing*" against an accused device in which the restraint loses contact with the barrier "just prior to staple firing.")

Further, as discussed above, chemical ranges -- such as those present in *Warner-Jenkinson* -- have also confounded the Federal Circuit, leading to inconsistent and unpredictable results. Compare *Ortho-McNeill*, 476 F.3d 1321 (applying the vitiation doctrine to a claimed range), with *Abbott Laboratories v. Andrx Pharmaceuticals*, 473 F.3d 1196 (declining to apply the vitiation doctrine to a claimed range).

From a review of the vitiation case law, Petitioner respectfully submits that it is not possible to reliably predict whether or not particular claim language will trigger a finding of vitiation. Indeed, there is no guarantee that virtually the same claim term will receive identical treatment for purposes of the "vitiation" doctrine from case to case.[7] Resolution of a vitiation claim before the Federal Circuit is panel-dependent, with any disposition of such a claim capable of being supported by one line of vitiation cases or another. Indeed, the existence of conflicting lines of vitiation cases confounded the district judge in this case, and his opinion expressly acknowledged that Planet Bingo would prevail under one line of vitiation cases. In the process, the

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7 Indeed, in the *Depuy Spine* case, the Federal Circuit reached the opposite result from a prior case that involved virtually the same structural language – "conical" versus "spherical." *See Tronzo*, 156 F.3d 1154.

Federal Circuit's "vitiation doctrine" has become un-tethered from this Court's fundamental teaching that a finding of equivalents is based on whether the differences between the claimed and accused element are only "insubstantial." *Festo, supra.*

c. The Decision in this Case Potentially Expands the Vitiation Doctrine to Every Infringement Claim Based on the Doctrine of Equivalents

To make matters worse, the decision in this case represents a fundamental expansion of a vitiation doctrine which, as shown above, was already confusing and unpredictable. The district court and the Federal Circuit both placed dispositive emphasis on the fact that the word "after" is the opposite of "before." App. 13a ("In this case, the proposed application of the doctrine of equivalents would change `before' to `after' . . . ."). However, the term "before" is not in any of the *claims* that were at issue. While the Federal Circuit, in most respects, has been unpredictable in its application of the vitiation doctrine, one aspect of its vitiation jurisprudence had been relatively consistent. Where the vitiation doctrine had been applied in the past, and as reflected in every vitiation case cited by the Federal Circuit in support of the decision in this case, it was based on specific language in the *claim* itself. See, *e.g.*, *Asyst Technologies*, 402 F.3d 1188 ("mounted"); *Cooper Cameron.*, 291 F.3d 1317 ("above"); *Moore*, 229 F.3d 1091 (Fed. Cir. 2000) ("majority"); *Sage Products* ,126 F.3d 1420 ("within").

Where applied, the vitiation doctrine was used to punish the patentee for the selection of a particular narrowing term or terms during claim drafting, which deprived the Patent Office of the ability to examine broader claim language. See, *e.g.*, *Sage Products*, 126 F.3d at 1425

("If Sage desired broad patent protection . . . it could have sought claims with fewer structural encumbrances. Had Sage done so, then the Patent and Trademark Office (PTO) could have fulfilled its statutory role in helping to ensure that exclusive rights issue only to those who have, in fact, contributed something new, useful, and unobvious."). Indeed, the decision below specifically invoked this rationale here. App. 12a ("This court cannot . . . expand the doctrine of equivalents beyond its purpose to allow recapture of subject matter excluded by a deliberate and foreseeable claim drafting decision.")

However, in this case, there was no decision by the patentee to include the word "before," or the phrase "before the first bingo ball," in any claim. Instead of "before the first bingo ball," the patentee chose the words "establishing" a "progressive . . . predetermined winning combination" for inclusion in the claims. Yet the Federal Circuit's decision noted that "Rainbow Bingo certainly contains a "progressive ... predetermined winning combination," indeed it would be impossible to play without one." App. 9a. Similarly, the district court found that Rainbow Bingo had "some predetermined aspects." The net effect of the Federal Circuit's decision below is to punish the patentee for a "deliberate and foreseeable *claim drafting* decision" that he did not make. The patentee's actual claim wording was, in fact, remarkably prescient.

According to the Federal Circuit's decision below, it is now the law that the claim interpretation ultimately adopted by the district court, years after issuance of the patent (and based on rules of interpretation that evolved subsequent to issuance), becomes a "deliberate and foreseeable *claim drafting* decision." This is so even where the precise words included in the interpretation were not used by the patentee in the specification or prosecution

history, much less in the claim itself. This has the effect of making the "vitiation" doctrine potentially applicable to *every* doctrine of equivalents case.8

d. The Vitiation Doctrine Improperly Seeks to Extend Prosecution History Estoppel

The Federal Circuit's rationale for application of the vitiation doctrine in this and other cases – i.e., that the patentee is being punished for a claim drafting decision – is inappropriate for an additional, fundamental reason. The doctrine of prosecution history estoppel, which this Court addressed in *Festo*, supplies an important limitation on the doctrine of equivalents. Prosecution history estoppel applies where a patentee responds to a patent "rejection by narrowing his claims." In such instance, "this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent." 535 U.S. at 727.

In *Festo*, the Federal Circuit had attempted to radically alter long-standing prosecution history estoppel jurisprudence, which applied a flexible bar when considering what claims of equivalence were estopped by the prosecution history. The court of appeals sought to adopt in its place a "complete bar," holding that "by narrowing a claim to obtain a patent, the patentee surrenders all equivalents to the amended claim element." 535 U.S. at 727. This Court reversed, rejecting the Federal Circuit's complete bar. *Id.* at 737 ("Though prosecution history estoppel can bar a patentee from challenging a wide range of alleged made or distributed by competitors, its reach requires an examination

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8 Indeed, one of the "vitiation" cases decided since the Federal Circuit's decision here also included an invocation of the doctrine based on the claim interpretation, rather than a specific claim term. *See Abbott Laboratories v. Andrx Pharmaceuticals*, 473 F.3d at 1212.

of the subject matter surrendered by the narrowing amendment.")

Prosecution history estoppel is the vehicle for the district court, as a matter of law, to bar an assertion of infringement under the doctrine of equivalents based on particular words used in the claims. 9 However, as applied by the Federal Circuit in this and other cases, the vitiation doctrine visits the consequences of prosecution history estoppel on a patentee (i.e., the loss of an equivalence claim) who is *not* seeking to renege on its bargain with the patent office. Indeed, the vitiation doctrine is more draconian than the complete bar of the Federal Circuit's *Festo* decision, which at least premised the loss of equivalence on a conscious decision to narrow claim scope in order to obtain a patent. Here, not even that basic finding is required. Moreover, an applicant could have avoided the Federal Circuit's complete bar by simply not amending at all, and instead appealing a claim rejection by the Patent Office. The vitiation doctrine, however, is a fully concealed trap. All claims are potentially subject to a finding of vitiation without any volitional conduct on the part of the patentee -- beyond the statutorily mandated act of including within the patent a single patent claim. See 35 U.S.C. § 112.

e. The Vitiation Doctrine Increases Uncertainty

The Federal Circuit's vitiation doctrine undoubtedly permits district courts to lighten their dockets in cases where it is applied. However, in *Festo*, this Court admonished against the adoption of rules that "may conserve judicial resources," but that would permit "[u]nimportant and insubstantial substitutes" that could "destroy[]" patent value.

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9 There was no assertion or finding in this case that plaintiff's theory of equivalence was barred by prosecution history estoppel.

535 U.S. at 731-732. The vitiation doctrine, like the Federal Circuit's complete bar in its *en banc* decision in *Festo*, is precisely such a rule.

To the extent that the vitiation doctrine represents an attempt – albeit an unsuccessful one in light of the conflicting Federal Circuit case law -- to avoid the uncertainty inherent in an equivalence analysis, that too provides no justification for the panel decision below. This Court has acknowledged that "the doctrine of equivalents renders the scope of patents less certain." *Festo*, 535 U.S. at 732. It has also pointed out that uncertainty about patent scope may deter competitors "from engaging in legitimate manufactures outside its limits" and may lead to "wasteful litigation between competitors . . . that a rule of literalism might avoid." *Id.* Nevertheless, this uncertainty is "the price of ensuring the appropriate incentives for innovation." *Id.* If equivalence is to be eliminated, "it is Congress and not the Court that should do so." *Id.* at 733.

In any event, the vitiation doctrine increases rather than reduces uncertainty. Some structural or temporal or chemical range word choices may be determined – in a vacuum and without considering evidence of substantiality of differences – to preclude as a matter of law any assertion of the doctrine of equivalents. Similar word choices may not stand in the way of such a determination. Indeed, the district court's opinion openly acknowledged that Planet Bingo would have prevailed under one line of Federal Circuit vitiation cases, but ruled against it based on another line. Moreover, findings of vitiation may not only be based on words selected by the patentee for inclusion in the claims (or even in the specification or prosecution history), but even on different words used by a court years later in interpreting those claims. This lack of clarity and the increased zone of uncertainty that it creates disserves both patent holders and

potential infringers and impairs the value of patents. A return to this Court's fundamental teachings on equivalence will remove this unnecessary and complicating filigree to the doctrine of equivalents, and eliminate this emerging threat to patent value.

2. A Finding of "Vitiation" Cannot be Made in the Face of Evidence that the Differences are only "Insubstantial"

As noted above, it is fundamental according to this Court's precedent that application of the doctrine of equivalents turns on whether the differences between the claimed and accused elements are only "insubstantial." *See Festo*, 535 U.S. at 722 ("patent claims must protect the inventor . . . from copyists who 'make unimportant and insubstantial changes and substitutions") (quoting *Graver Tank*, 339 U.S. at 607). While *Warner-Jenkinson* permitted some flexibility in determining exactly how such a determination might be made, it in no way changed the baseline inquiry.10

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10 The Court noted the "debate" regarding the "linguistic framework under which 'equivalence' is determined." 520 U.S. at 39. It referenced the "triple-identity" test, which focuses on the *function* served by a claim element, the *way* the element performs the function, and the *result* obtained. *Id.*; *see also Graver Tank*, 339 U.S. at 608 ("'To temper unsparing logic and prevent an infringer from stealing the benefits of the invention' a patentee may invoke this doctrine to proceed against the product of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'") (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42, 50 S.Ct. 9, 13, 74 L.Ed. 147 (1929)). It also briefly discussed the less rigid, "insubstantial differences" approach. *Warner-Jenkinson*, 520 U.S. at 39. In the end, the Court concluded that "the particular linguistic framework used is less important than whether the test is probative of the central inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element the patented invention?" *Id.* at 40.

The "vitiation" concern addressed in *Warner-Jenkinson* relates to the "particular facts" of the case, rather than the happenstance of word choice. *Warner-Jenkinson Co.*, 520 U.S. at 39 n.8. Thus, a finding of "vitiation" is only appropriate "[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent." *Id.* at 39 n. 8.

There could not have been a finding in this case, as a matter of law, that the differences were simply too substantial to support a jury finding of equivalence. The record evidence showed that there was no substantial difference between establishing the combination before or immediately after the calling of the first ball – in either case, it occurred before anything meaningful happened in the game. Indeed, the district court itself noted that there was only a "slight difference in timing" between establishing the progressive winning combination "before and after the first ball is drawn." The Federal Circuit went even further, stating that "Rainbow Bingo certainly contains a 'progressive . . . predetermined winning combination,' indeed it would be impossible to play without one."

Accordingly, a finding of vitiation should be limited to those cases where application of the doctrine of equivalents would truly "vitiate" an express, narrowing claim limitation, because the differences between the claim element and the accused device are sufficiently substantial that no reasonable jury could find equivalence. *Warner-Jenkinson*, 520 U.S. at 39 n. 8.

3. The Federal Circuit's "Vitiation Doctrine" Improperly Takes the Doctrine of Equivalents out of the Hands of the Jury, Contrary to this Court's Holdings that the Doctrine of Equivalents is a Jury Issue

In *Warner-Jenkinson*, this Court reviewed an *en banc* decision of the Federal Circuit. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*). One of the issues that the full Federal Circuit had considered was whether the issue of infringement under the doctrine of equivalents was an issue for the judge or jury to resolve. It held that it was a jury issue. *Id.* at 1522 ("infringement under the doctrine of equivalents is an issue of fact to be submitted to the jury in a jury trial"). Relatedly, it held that the "trial judge does not have discretion to choose whether to apply the doctrine of equivalents when the record shows no literal infringement." *Id.*

This Court noted that "[t]here was ample support in our prior cases" for the *en banc* panel's holding that the doctrine of equivalents is a jury issue. 520 U.S. at 38. However, the Court declined to resolve the question. *Id.* It noted that "[w]hether, if the issue were squarely presented to us, we would reach a different conclusion than did the Federal Circuit is not a question we need decide today." *Id.* at 39. This petition squarely presents that issue.

The "prior cases" to which this Court was referring included *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877); and *Winans v. Denmead*, 15 How. at 344). Their holdings on this issue are clear. *Union Paper-Bag*, 97 U.S. at 125 ("in determining the question of infringement, the court or jury, as the case may be . . . are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and

how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result"); *Winans*, 15 How. at 344 (holding that it is "question for the jury" whether the accused device "substantially" embodied "the patentee's mode of operation."). Other early Supreme Court cases contained similar holdings. See *Royer v. Schultz Belting Co.*, 135 U.S. 319, 325, 10 S.Ct. 833, 34 L.Ed. 214 (1890); *Tyler v. Boston*, 74 U.S. 327, 19 L.Ed. 93 (1868).

In the Federal Circuit's *en banc* decision in *Warner-Jenkinson*, it is telling that none of the dissenting judges could point to any decision of this Court supporting an assignment of this specific issue to the judge rather than the jury. See, *e.g.*, 62 F.3d at 1549 ("I recognize that Supreme Court case law has not reserved determination of infringement under the doctrine to the judge.") (Lourie, J., dissenting); 62 F.3d at 1579 ("I conclude that a finding of infringement under the doctrine of equivalents is a mixed question of law and fact.") (Nies, J., dissenting); 62 F.3d at 1542 ("it is easy to point to cases, old and new, in which, when a jury was impaneled, the function-way-result issue was given willy-nilly to the jury along with the issue of literal infringement") (Plager, J., dissenting).

The "vitiation doctrine," as applied by the district court in this case, improperly took resolution of plaintiff's doctrine of infringement claim away from the jury. Because there was sufficient evidence for a reasonable jury to find only "insubstantial" differences between the claimed "predetermined winning combination" and the Rainbow Bingo progressives, the issue should not have been decided by the Court as a matter of law.

Petitioner notes that those judges who have advocated assigning the doctrine of equivalents to judges for resolution have not done so in order to permit the type of sterile, linguistic test applied here. Rather, their argument has been that the doctrine of equivalents, while requiring the resolution of some factual issues, is essentially an appeal to the equitable powers of the district court. See 62 F.3d at 1550. In their view, assigning the issue to the judge permits consideration of the various equitable concerns underpinning the doctrine. *Id.* ("The judge needs to decide whether, given the purpose of the doctrine to defeat piracy, a party who is more of a copier than an independent developer, has made only insubstantial changes in the claimed invention, such that, in light of all the other factors, it is appropriate to find that party to be an infringer even though its activities are literally outside the scope of the patent claims.")

No such consideration of the equities occurred here. If it had, the outcome would have been favorable to Planet Bingo. The evidence showed that GameTech considered Planet Bingo to be a "cancer," GameTech "inventors" obtained under false pretenses a videotape of MP Bingo during the design phase, GameTech had full knowledge of the '289 and '786 Patents during product development, and so on. Accordingly, even if this Court were to conclude that resolution of the doctrine of equivalents should be reassigned from the jury to the judge for the exercise of the court's equitable powers, remand would still be appropriate so that a proper consideration of the equities could occur.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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APRIL 23, 2007

APPENDIX

United States Court of Appeals for the Federal Circuit

05-1476

PLANET BINGO, LLC.

Plaintiff/Counterclaim
Defendant Appellant,

and

GARY WEINGARDT,

Counter Defendant-
Appellant,

v.

GAMETECH INTERNATIONAL, INC.,

Defendant /
Counterclaimant
Appellee,

and

RICHARD FEDOR, GARY HELD and GRAHAM LEONARD,

Defendants-Appellees.

DECIDED: December 13, 2006

Before NEWMAN, MAYER, and RADER, Circuit Judges.

RADER, Circuit Judge.

The United States District Court for the District of Nevada determined that GameTech International, Inc., did not infringe claims 3, 6-9 of U.S. Patent No. 5,482,289 (the '289 patent) and claims 1, 4, 7, 8,11,12,15,16,19,21,24,25, 28, 32, and 35-39 of U.S. Patent No. 5,727,786 (the '786 patent) belonging to Planet Bingo, LLC. Planet Bingo, LLC v. GameTech Int'l, Inc., CV-S-01-1295-PMP (D. Nev. Apr. 18, 2005) (Infringement Decision). The district court further found in a separate order that prior art anticipated claims 2 and 5 of the '289 patent under 35 U.S.C. § 102(b). Planet Bingo, LLC v. GameTech Int'l, Inc., CVS-01-1295-PMP (D. Nev. May 6, 2005) (Invalidity Decision). Finding no error, this court affirms the district court's findings.

I.

Planet Bingo, LLC (Planet Bingo) is the exclusive licensee of both the '289 and '786 patents. The patents claim alternative methods of playing bingo by coupling numbers with additional "indicia" or "markings," such as colors or shading patterns. See, e.g., '289 patent, col.5 ll.27-29; '786 patent, col.3 ll.48-52. These additional designations overlay a traditional bingo game to produce more winning combinations for more prizes. For example, a player may achieve a classic bingo (e.g., a straight line) and then couple that line with an additional indicator (e.g., a straight line that is also all red) to win a greater jackpot. The additional designations come into play either with markings on the bingo balls in the '289 patent or with a marked bingo flashboard in the '786 patent. '289 patent, col.5 ll.20-25; '786 patent, col.3 ll.40-50. The patents also specify that players might make a second, separate wager to access a progressive jackpot. '289 patent, col.3 ll.6-10; '786 patent, col. 3 ll.21-24.

In this type of bingo with wagers, the unclaimed purse in each round carries over to the next game (think Powerball). See, e.g., '289 patent, col.3 ll.42-44. The bingo hall may also set aside a portion of this second wager to pay winners of the progressive jackpots. Id. at col.5 ll.38-51.

In August 2002, GameTech International, Inc. (GameTech), Planet Bingo's competitor in the gaming industry, began to exhibit their own version of bingo at trade shows. The accused version, "Rainbow Bingo," also includes an additional layer of markings, with different colors assigned to the columns of a bingo matrix, and jewels or coins assigned to the rows. The "Rainbow Bingo" game randomly distributes the extra winning combinations only after drawing the first bingo ball. Rainbow Bingo also features progressive jackpots by carrying over prize amounts into the next game until a winner claims the jackpot associated with a particular color, coin, or jewel. Though Rainbow Bingo can be played on conventional bingo cards using a specialized flashboard, GameTech also envisioned linking many bingo halls through electronic bingo cards. This feature made very large progressive prizes possible, including a "life changing prize" for a ruby bingo.

Planet Bingo brought suit against GameTech on November 2, 2002. The complaint specified that GameTech offered an infringing version of Rainbow Bingo for sale. Planet Bingo charged infringement of certain claims of the '289 patent and the '786 patent. GameTech asserted that Rainbow Bingo did not infringe two limitations from each patent: (1) using indicia to mark the bingo balls (in the '289 patent) or the bingo board (in the '786 patent), and; (2) establishing a predetermined winning combination (in both the '289 patent and the '786 patent). GameTech further challenged that a prior art bingo game anticipated these patents.

A magistrate judge held a Markman hearing and construed fourteen claim limitations in favor of GameTech. Planet Bingo, LLC v. GameTech Inn Inc ., CVS-01-1295-JMC (D. Nev. Nov. 3, 2004). The district court later adopted this claim construction to support its finding of no infringement. Infringement Decision, slip op. 10. Because the accused device marked the bingo card rather than the bingo balls, and assigned the specific winning combinations only after drawing the first bingo ball, the district court found no infringement-literal or under the doctrine of equivalents. Id. at 11, 17. The district court relied on the winning combination limitation alone to reach this result. Id. The district court, therefore, granted summary judgment for GameTech. Id. at 17.

The district court considered the counterclaim of invalidity in a separate motion in limine. To challenge claims 2 and 5 of the '289 patent, GameTech relied on an antecedent game known as "HOTBALL," a form of progressive bingo developed in 1991. Invalidity Decision, slip op. 9. Planet Bingo appeals the district court's non-infringement and invalidity findings.

II.

"This court reviews the district court's grant or denial of summary judgment under the law of the regional circuit." MicroStrategy, Inc. v. Bus. Objects, S.A., 429 F.3d 1344, 1349 (Fed. Cir. 2005) (citation omitted). The United States Court of Appeals for the Ninth Circuit, "reviews a district court's summary judgment order de novo, viewing all facts and reasonable inferences therefrom in the light most favorable to the nonmoving party." Diruzza V. County of Tehama, 323 F.3d 1147, 1153 (9th Cir. 2003).

INFRINGEMENT

Infringement entails a two-step process: "First, the court determines the scope and meaning of the patent claims asserted ... [and second,] the properly construed claims are compared to the allegedly infringing device." Cybor Corp. v. FAS Tech. Inc., 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en bane) (citations omitted). "Step one, claim construction, is a question of law, that we review de novo. Step two, comparison of the claims to the accused device, is a question of fact, and requires a determination that every claim limitation or its equivalent be found in the accused device." N. Am. Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1344 (Fed. Cir. 2005) (citations omitted).

The district court construed the limitation "progressive ... predetermined winning combination" to mean the precise elements necessary to achieve bingo in a particular game are known before the first bingo ball is drawn. Infringement Decision, slip op. 10. All of the asserted claims contain this limitation. The district court's opinion for both non-infringement and invalidity rested on its reading of this limitation.

Claim 2 of the '289 patent shows this limitation in context:[1]

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[1] The district court found this claim invalid in view of HOTBALL but offered no decision regarding infringement of this claim.

2. The method of playing a game of bingo comprising:

a) providing a player with a bingo card having a plurality of numbered spaces formed as a matrix having five rows and five columns used in the play of a five-by-five bingo game;

b) providing a plurality of bingo balls, each having individual numbers corresponding to the numbered spaces on the bingo card;

c) a player making a first wager to be eligible for the five-by-five bingo game[;]

d) a player making a second wager to be eligible for a progressive jackpot;

e) randomly selecting consecutive bingo balls;

f) awarding a first preselected amount when the player achieves a predetermined winning combination on the five-by-five matrix of the bingo card;

g) designating a portion of the second wager to a separate progressive jackpot pool;

h) establishing a predetermined combination as a winning combination for the progressive jackpot pool; and

i) awarding the progressive jackpot pool to the player when he achieves the predetermined winning combination on the bingo card.

'289 patent, col.7 ll.31-55 (emphasis added).

On appeal, GameTech argues that, the "progressive ... predetermined winning combination" limitation requires fixation of the entire winning combination before drawing the first bingo ball in any given bingo game. According to GameTech, a player of a Planet Bingo game will know ahead of time that "red" squares will give the progressive bingo and the position of those red squares on the board, but a player of Rainbow Bingo will not know this information until after the first ball is drawn. Planet Bingo responds that "progressive ... predetermined winning combination" merely requires that the participants in the game know, before the start of play, the predetermined rules for winning a progressive jackpot. Planet Bingo argues that the disclosure only requires that the player know in advance that he (according to claim 2 of the '289 patent) is playing for a red bingo to win the progressive prize, not what the exact location on the board the red squares will be before the game begins. Thus, the claims recite a "progressive ... predetermined winning combination," but the parties dispute what must be predetermined before drawing the first bingo ball.

The claim language governs claim meaning. Phillips v. AWH Corp., 415 F.3d 1303,1312 (Fed. Cir. 2005) (en bane). In this case, the claim language supports GameTech's construction. The claims recite a "progressive . predetermined winning combination" not merely "predetermined rules" for identifying a winning combination. The rules may dictate that a "red bingo" will win the progressive game. The winning combination, however, identifies the particular squares, colored red, that will produce the progressive bingo.

Further, the claim's preamble calls for "a game" of

bingo. While the rules for a particular progressive jackpot may require achieving bingo with red squares, the winning combination for that game is something different; i.e., a straight red bingo, a diagonal red bingo, a four corners red bingo, etc. Each game will have a particular "progressive ... predetermined winning combination." The claims themselves specify that each individual game, rather than the rules for overall play, will have a different winning combination.

The specification often supplies the critical context to construe the claim language. Philips, 415 F.3d at 1315. In this case, again, the discussion of the disputed term in the specification supports the district court's construction. Repeatedly the specification explains that the game determines the "winning combination" before the first bingo ball is drawn, thus making it "predetermined." For example, the '289 patent states: "The operator of the bingo game will designate at the beginning of the game which particular combination or combinations of covered spots will be winning combinations for that particular game." Col.1 ll.34-37. The '289 patent states that, in the preferred embodiment, "[a] winning combination is established for the progressive jackpot pool and bingo balls are randomly selected." Col.6ll.12-13. The '289 patent uses this exact same phrase again to describe an alternative embodiment. Col.6 ll.28-29.

Likewise, the '786 patent states: "The operator of the bingo game will designate at the beginning of the game which particular combination or combinations of covered spots will be winning combinations for that particular game." Col.1 ll.41-45. The '786 patent goes on to describe a feature of the invention, the electronic display board, noting that "[p]rior to each game, some of the numbers on the display board are specifically designated with the first distinctive marking and a smaller portion of the numbers on

the display board are specifically designated with the second distinctive marking." Col. 3 ll.12-15.

The summary of the invention for the '786 patent states: "At the beginning of each game, an electronic random number generator selects a predetermined group of bingo numbers" which will be blue, green, red, and so forth. Col.3 ll.3740. The '786 patent goes on to state that the electronic board illuminates the colors so that "[e]ach player can then see at the beginning of a game which of the bingo numbers have the various distinctions." Col.5 ll.31-33. Finally the '786 patent reiterates: "The only modification that a bingo establishment needs to undertake to practice the method of the present invention is to install the electronic reader board that can show different designations on the numbers on the board as well as a random number generator to predetermine which numbers are going to have which designations in a particular game." Col.5 1.64-Col.6 1.3. Thus, these passages inform the meaning of "progressive ... predetermined winning combination," specifying both what it is and when it occurs. Specifically, the specification invariably fixes the winning combinations before a game starts.

The district court determined that GameTech did not infringe either literally or under the doctrine of equivalents because the accused device does not determine the winning combination until after the first bingo ball is drawn; i.e., until after the game begins. Infringement Decision, slip op. 11-12, 17. This court affirms the district court's ruling that Rainbow Bingo does not literally infringe these claims because it does not determine the winning combination until after drawing the first ball. Rainbow Bingo certainly contains a "progressive predetermined winning combination," indeed it would be impossible to play without one. However, the '289 and '786 patents use this term to set that winning combination before the game begins. In this sense, Rainbow

Bingo does not disclose to a player the predetermined winning combination until after the game is underway. Thus, Rainbow Bingo does not contain a necessary limitation. The district court correctly found that GameTech does not literally infringe the claims. See Baver AG v. Elan Pharm. Research Corp., 212 F.3d 1241, 1247 (Fed. Cir. 2000).

Asserting infringement under the doctrine of equivalents, Planet Bingo argues that the Rainbow Bingo game incorporates only an insubstantial variation from the claims because the progressive predetermined winning combination appears right after, rather than right before, the first bingo ball is drawn. Equivalents are questions of fact reviewed under the clearly erroneous standard. Insta-Form Prods., Inc. v. Universal Foam Sys., Inc., 906 F.2d 698, 702 (Fed. Cir. 1990). Planet Bingo bears the burden of showing that the accused method may perform substantially the same step, in substantially the same way, with substantially the same result. Toro Co. v. White Cons. Ind., 266 F.3d 1367, 1370 (Fed. Cir. 2001).

According to Planet Bingo, the timing of the predetermined winning combination does not affect the game's prize amounts, odds, or other essential characteristics. Further, Planet Bingo argues, players of Rainbow Bingo will know of the blue, purple, ruby, and emerald progressive combinations before the first bingo ball is drawn. The only thing, argues Planet Bingo, that a player of Rainbow Bingo will not know before the first bingo ball is drawn is where those progressive combinations will be locked in. GameTech in turn argues that waiting for the first ball to be drawn does make a substantial difference in the game because it increases the excitement.

The district court found, contrary to Planet Bingo's assertion, that "after" and "before" are very different.

Infringement Decision, slip op. 16. The district court determined that it could not substitute this change without ignoring entirely the claim limitation. Id. at 13 (citing Cooper Corp. v. Kvaerner Oilfield Prods., Inc., 291 F.3d 1317, 1322 (Fed. Cir. 2002)). The district court also relied on a line of cases from this court construing the doctrine of equivalents "narrowly." Infringement Decision, slip op. 14-15 (citing Asvst Techs., Inc. v. Emtrak, Inc., 402 F.3d 1188 (Fed. Cir. 2005); Moore U.S.A., Inc. v. Standard Resister Co., 229 F.3d 1091 (Fed. Cir. 2000); Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420 (Fed Cir. 1997)). The district court determined that the game method in which the winning combination is not known until after the game begins cannot be equivalent to a game method where this occurs before because "after is opposite of before, not equivalent." Infringement Decision, slip op. 16.

The Supreme Court emphasizes that the doctrine of equivalents must not expand to eliminate a claim element entirely. Warner-Jenkinson v. Hilton Davis Chem. Co., 520 U.S. 17, 29 (1997). The doctrine does provide additional coverage for the exclusive right to protect a patent holder in the event of an unforeseeable change. Sage Prods., 126 F.3d at 1425 ("However, as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure ... . [T]he alternative rule-allowing broad play for the doctrine of equivalents to encompass foreseeable variations, not just of a claim element, but of a patent claim-also leads to higher costs.") (citation omitted). Here, the patents contain a distinct limitation, which was part of the bargain when the patent issued. This court cannot overlook that limitation or expand the doctrine of equivalents beyond its purpose to allow recapture of subject matter excluded by a deliberate and

foreseeable claim drafting decision. See Id..

Further, the cases Planet Bingo cites in support of a broad interpretation to the doctrine of equivalents, specifically Ethicon Endo-Surgery, Inc. v. United States Corp., 149 F.3d 1309 (Fed. Cir. 1998), and Wright Medical Technology v. Ostenoics Corp., 122 F.3d 1440 (Fed. Cir. 1997), do not alter this court's present analysis. In Wright Medical, this court remanded the district court's decision of summary judgment under the doctrine of equivalents because evidence showed that the accused medical device that only passed through part of the femur, rather than through the femur, may be found to be equivalent because it achieves at least some of the functionality of the claimed invention. 122 F.3d at 1446. Further, in Ethicon, this court found that the accused device infringed under the doctrine of equivalents because of the length of time a restraint structure contacted a barrier was minimal. 149 F.3d at 1313. The court in Ethicon distinguished Sage Prods., noting that in Sage Prods. "no subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of the limitation at the time of its incorporation into the claim." Ethicon, 149 F.3d at 1318 (quoting Sage Products, 126 F.3d at 1425). Arguably, the facts surrounding the inventions (both medical devices) in both Wright and Ethicon made the disputed differences less foreseeable at the time the patent was drafted.

Further, the Ethicon and Wright cases dealt only with questions of small variations in the degree of achieving a claimed limitation. See Ethicon, 149 F.3d at 1321; Wright, 122 F.3d at 1445. In this case, the proposed application of the doctrine of equivalents would change "before" to "after," a more marked difference. This court has refused to apply the doctrine in other cases where the accused device

contained the antithesis of the claimed structure. For example, in Moore, this court refused to find infringement under the doctrine of equivalents for an accused product with only a minority of adhesive strips where the claim called for a majority. 229 F.3d at 1106. Similarly, in Asvst Technologies, an unmounted computer was not an equivalent to a claim limitation requiring a mounted computer. 402 F.3d at 1195. Finally, in Sage, an elongated slot within, rather than on top of, the claimed container did not infringe under the doctrine of equivalents. 126 F.3d at 1425-26.

Similarly, in this case, the difference in timing creates a difference of knowing the winning combination before the game starts or after the game starts. Rainbow Bingo always determines the winning combination after start of the game. Therefore, it cannot be "predetermined." This court upholds the district court's refusal to find infringement by equivalents.

ANTICIPATION

In a separate order, the district court held claims 2 and 5 of the '289 patent invalid as anticipated by the prior art bingo game HOTBALL. Invalidity Decision, slip op. 8-9. Claim 2 is produced in its entirety above. Claim 5, an independent claim, is identical to claim 2 except that claim 2 additionally requires a five-by-five bingo matrix card. '289 patent, co I. 7 ll.39-40; col.8 ll.29-30. HOTBALL is a prior art bingo game that was marketed to gaming operators in July 1991. The applicant did not cite, and the Patent and Trademark Office did not consider, this prior art bingo method.

HOTBALL is a bingo game in which, before the start of the game, the player places a wager to play the conventional bingo game, and then places a second wager to

play HOTBALL. Originally, HOTBALL was marketed as a method in which the player would pick the HOTBALL number. However, some bingo halls played HOTBALL differently. Under the alternative method, the game operator would select the HOTBALL number by drawing a bingo ball out of the hopper, announcing it as the HOTBALL. If the player achieved bingo with the selected HOTBALL number as the last number that formed the pre-selected winning combination, the player won a separate HOTBALL jackpot. A July 1991 promotional letter described this alternative method of playing HOTBALL.

A claim is anticipated and thus invalid if each and every limitation of a claim is found, expressly or inherently, in a single prior art reference. Schering Corp. v. Geneva Pharm., 339 F.3d 1373, 1379 (Fed. Cir. 2003). The district court determined that HOTBALL disclosed each and every limitation of claim 2 and 5. In particular, the district court determined that both HOTBALL and claims 2 and 5 required a "predetermined winning combination" before the start of the game. Invalidity Decision, slip op. 8.

At the district court, the parties agreed that HOTBALL disclosed every limitation of claim 2 and 5 of the '289 patent except for step (d), which requires "a player making a second wager to be eligible for a progressive jackpot", step (g), which requires "designating a portion of the second wager to a separate progressive jackpot pool", and step (h), which states "establishing a predetermined combination as a winning combination for the progressive jackpot pool." Id. at 6. The district court determined that the HOTBALL method contained the steps requiring a second wager and designating a portion of this wager to the progressive jackpot. Id. at 7. In addition, the district court determined that while nothing in the claims of the '289 patent require the "progressive ... predetermined winning

combination" to be determined by the game hall, the game can be played in this way. Id. Thus, at least when the game hall operator discloses the HOTBALL number at the outset, that prior selection met the "progressive ... predetermined winning combination" limitation because the winning combination would be a straight line with the HOTBALL number as the last number in the winning combination. Id.

On appeal, Planet Bingo argues that HOTBALL does not disclose the precise elements of the winning combination before the first ball is drawn. Specifically, Planet Bingo argues that the progressive jackpot in HOTBALL is not based on a "predetermined winning combination" but rather on a player's ability to guess the last number needed for a bingo win.

HOTBALL requires that either a player or bingo hall operator pick a number before the start of the game that, if drawn as the final component of a bingo combination, gives the winner an additional progressive prize associated with that number (the HOTBALL number). The predetermined winning combination in the claims of the '289 patent does not require the player to know the numbers that will form the predetermined winning combination, only that the combination of one or more spaces on the bingo card matrix, which, when covered by a player, represents a bingo win; together with other necessary predetermined winning criteria. Here, a player of HOTBALL will know that they need a particular pattern to represent a bingo win and a predetermined HOTBALL number on the last ball to win the progressive prize. Thus, this court affirms the district court's finding that the HOTBALL method anticipates claims 2 and 5 of the '289 patent.

COSTS

Each party shall bear its own costs.

AFFIRMED

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

PLANET BINGO, LLC.

Plaintiff,

V.

GAMETECH INTERNATIONAL, INC.,
ET AL.

Defendants,
v.

GARY WEINGARDT,

Third-Party Defendant.

CV-S-01-1295-PMP (PAL)

SEALED ORDER

Presently before the Court is Defendants' Motion in Limine to Exclude Evidence of All Infringement of U.S. Patent Nos. 5,482,289 and 5,727,786 (#1) (Doc. #292), filed on November 17, 2004. On December 21, 2004, Plaintiff filed Plaintiff filed Plaintiff Planet Bingo, LLC's Opposition to Gametech International, Inc.'s Motion in Limine to Exclude Evidence of U.S. Patent Nos. 5,482,289 and 5,727,786 (#1) (Doc. #322).

I. BACKGROUND

Plaintiff Planet Bingo, LLC, ("Planet Bingo") and Defendant Gametech International, Inc. ("Gametech") are competitors in the bingo industry. Planet Bingo is the licensee on two patents held by third party defendant Gary Weingardt ("Weingardt"), patent numbers 5,482,289 (the "'289" patent) and 5,727,786 (the "'786" patent). (Joint Pre-Trial Order (Doc. #344) at 4.) Both patents relate to a method of bingo game play involving assigning indicia to either the bingo balls in the '289 patent or the bingo flashboard in the '786 patent to create winning combinations beyond a conventional bingo winning combination. (Non-Confidential Decl. of Evette D. Pennypacker in Supp. of Defendants' Mots. In Limine (Nos. 1-5) ("Non-Confidential Pennypacker Decl.") (Doc. #295), Exs. 4, 7.) For example, by making certain bingo balls or spaces on the flashboard read, a player could win a separate progressive jackpot prize for an all red bingo. (Id.)

Planet Bingo brought this infringement suit alleging Defendants infringed on the '289 and '786 patents by offering for sale a bingo game method called "Rainbow Bingo," which purports to mark bingo cards or a monitor display with indicia to create additional winning combinations for progressive jackpots. (Am. Compl. (Doc. #102); Confidential Decl.. of Calvin Nicholson in Supp. of Defs.' Mot. In Limine Regarding Non-Infringement (#2) (Doc. #293) ("Nicholson Decl."), Ex. 1.) Defendants deny infringement of either patent and contest the patents' validity. (Answer and Countercl. Of Defs. GameTech Int'l, Inc. Richard Fedor, Gary Held and Graham Leonard to Am. Compl. (Doc. ##151, 152).)

A conventional bingo game involves bingo cards, bingo balls, a hopper or blower, and a flashboard. (Nicholson

Decl. at ¶ 10.) The blower is used to randomly select bingo balls marked with letters and numbers.(Id.) The flashboard keeps track of and informs the players of which balls have been selected. (Id.) A conventional flashboard is a large number reader board consisting of numbered spaces corresponding to each numbered bingo ball available in the game. (Id. at ¶ 13.) As each ball is selected in a particular game, the corresponding space on the flashboard is lit to indicate to players in the hall that the number has been called. (Id. at ¶¶13, 16.)

The players have one or more bingo cards on which to play. (Id. at ¶ 10.) A bingo card is a matrix of rows and columns with numbers that correspond to a subset of the bingo balls available for selection in the game. (Id. at ¶ 11.) A typical bingo card has five rows and columns. (Id.) The columns are labeled B, I, N, G, and O. (Id.) In a seventy-five number bingo game, the numbers divided among the columns as follows: B 1 through 15, I 16 through 30, N 31 through 45, G 46 through 60, and O 61 through 75. (Id.) Each card also includes a free space in the center. (Id.)

Before the game begins, the entity running the game announces the winning combination, such as a row, column, diagonal, or some other pattern on the player's bingo card. (Id. ¶14.) The balls are mixed in the hopper and the balls are randomly selected one 7 at a time. (Id. ¶16.) The caller announces the number on the selected ball. (Id.) Players mark any called numbers that match the numbers on their card until one player achieves the 9 winning combination and shouts "Bingo!" (Id.)

The '289 and '786 patents involve overlays to a typical bingo game. In the method described by the '289 patent, the bingo balls would be marked with "indicium" to differentiate bingo balls. (Non-Confidential Pennypacker

Decl., Ex. 5 at GTI000894-96.) For example, some balls would be colored red, others would be colored red with a black stripe, and the remainder would be colored white. (Id.) Players can win different prizes if 15 they achieve the predetermined winning bingo combination with all red, all striped, or all 16 white bingo balls. (Id.) The '786 patent describes a similar game method in which the differentiating colors or graphics are marked on the flashboard instead of on the bingo balls. (Non-Confidential Pennypacker Decl., Ex. 6 at GTI001308-11.)

Defendant GameTech has displayed at some trade shows a bingo game called Rainbow Bingo" that allegedly infringes on Weingardt's two patents. (Conf. Decl. of Karen J. Sepura in Supp. of Pl. Planet Bingo, LLC's Opp'ns to Defs.' Mots. in Limine (#2-5), Ex. Gat 68-69, Ex. Hat 72; Ex. 1.) According to GameTech, it never actually has sold Rainbow Bingo, and no one has played the game, or placed a wager or awarded any prizes 24 based on Rainbow Bingo play. (Nicholson Decl. at ¶ 17.) Planet Bingo's infringement claims rest on allegations that GameTech offered to sell Rainbow Bingo to customers at 26 gaming conventions and through other sales contacts. (Am. Compl. (Doc. # 102) at ¶¶ 20-32.)

The allegedly infringing version of Rainbow Bingo is described in an August 2002 PowerPoint Presentation prepared by GameTech employees Calvin Nicholson and 4 Mark Lowell. (Nicholson Decl., Ex. 1.) According to the presentation, Rainbow Bingo was a "patent pending game playing method" overlaying a conventional bingo game with a linked progressive component. (Nicholson Decl. at ¶18; Ex. 1 at GTI002280.) In Rainbow Bingo, after the first ball is called, each column of the bingo card randomly would be assigned a color, and each row randomly would be assigned a jewel or coin symbol. (Id. at GTI002280-81.) Additionally,

one diamond number would be selected within each set of numbers corresponding to B, I, N, G, and O. (Id. at GTI002280.)

The columns on the bingo card would be colored either pink, orange, blue or purple. (Id. at GTI002281.) The middle column would be either pink or orange. (Id.) Three of the remaining four other columns would be assigned the color blue. (Id.) The final column would be colored purple. (Id.) To win the colored column progressive prizes, a player would have to achieve a bingo in the particular colored column with one diamond number in the column. (Id.)

The rows on the bingo card would be assigned jewels or coins. (Id. at GTI002282.) The middle row would be either silver or gold coins. (Id.) Three of the four remaining rows would be assigned an emerald. (Id.) The last row would be assigned a ruby. (Id.) To win a jewel or coin progressive prize, the player would have to achieve a bingo on the jewel or coin row with three diamond numbers in the row. (Id). Rainbow Bingo also envisioned what GameTech termed a "life changing prize." (Id.) To win this prize, a player would have to achieve a ruby bingo with four diamond numbers in the row. (Id. At GTI002283).

The column prizes would increase progressively with each game played until a player in a specific bingo hall won. (Nicholson Decl. at ¶ 21.) The bingo hall would be responsible for paying the in-hall progressive prizes. (Nicholson Decl., Ex. 1 at GTI002285.) The larger row prizes would be linked among various bingo halls, and would increase progressively until a player in any of the linked halls won the particular jackpot. (Nicholson Decl. at ¶ 21.) GameTech would be responsible for paying the linked progressive prizes, and would fund the initial seed of these prizes. (Nicholson Decl., Ex. 1 at GTI002285.)

Rainbow Bingo could be played on both electronic bingo cards and on conventional paper bingo cards. (Nicholson Decl. at ¶¶ 22-23; Ex. 1 at GTIO02280, GTIO02296.) On the electronic card, the row, column, and diamond number designations would occur directly on the player's electronic bingo card. (Nicholson Decl. ¶ 22.) Players with paper cards would have to follow the designations for each game on a monitor display in the bingo hall. (Id. at ¶ 23.) The monitor display would show a bingo card matrix without any bingo numbers, and would cycle through each row and column to show the winning combinations and available prize amounts associated with that combination. (Id.; Nicholson Decl., Ex. 1 at GTIO02293-94.) The display monitor also would show the diamond numbers. (Nicholson Decl. at ¶ 24.; Nicholson Decl., Ex. 1 at GTI002293-94.) Additionally, the monitor display would show five tubes corresponding to the B, I, N, G, and O sets of numbers. (Nicholson Decl. at ¶ 24; Nicholson Decl., Ex. 1 at GTIO02292-94.) The tubes would show graphic images of bingo balls in the tubes as they are called in the game. (Nicholson Decl. at ¶ 24; Nicholson Decl., Ex. 1 at GTI002293-94.) Unlike a conventional flashboard, the monitor display does not show numbered spaces corresponding to all seventy-five numbers available in the game, but instead shows only those numbers actually called in the current game. (Nicholson Decl. at ¶ 24; Nicholson Decl., Ex. 1 at GTI002293-94.)

In Apri12003, GameTech moved for summary judgment, asserting that Rainbow Bingo does not infringe on the Weingardt patents as a matter of law. (Def. GameTech Int'l, Inc.'s Mot. for Summ. J. of Non-Infringement and Mem. of P. & A. in Supp. Thereof (Doc. #115) at 14-28.) GameTech argued that the Weingardt patents have two limitations upon which Rainbow Bingo does not infringe either literally or under the doctrine of equivalents: (1) that markings be made to the physical bingo balls or the flashboard, and (2) that the specific winning combination be known before the first bingo ball is drawn. (Id.) According to GameTech, Rainbow

Bingo marks the bingo card, not the balls or flashboard, and Rainbow Bingo does not designate row, column, and diamond numbers until after the first ball is called. (Id.; Non-Confidential Pennypacker Decl., Ex. 18 at 26-36.) On July 8, 2003, the Honorable James C. Mahan denied the motion, ruling that genuine issues of fact remained. (Mins. of Proceedings (Doc. # 188); Non-Confidential Pennypacker Decl., Ex. 18 at 54-55.) GameTech then requested a claim construction hearing pursuant to Markman v. Westview Instruments. Inc., 517 U.S. 370, 390 (1996). (Non-Confidential Pennypacker Decl., Ex. 18 at 57-59.)

The parties subsequently engaged in a claim construction hearing before the Honorable Peggy A. Leen. (Non-Confidential Pennypacker Decl., Ex. 2.) Judge Leen entered an order construing the claims in the Weingardt patents on August 27,2004. (Non-Confidential Pennypacker Decl., Ex. 1.)

Based on Judge Leen's claim construction, GameTech filed this motion in limine. again arguing that Rainbow Bingo does not infringe on the Weingardt patents as a matter of law. GameTech contends that under Judge Leen's claim construction, Rainbow Bingo does not infringe the Weingardt patents either literally or under the doctrine of equivalents because Rainbow Bingo marks the bingo card rather than the physical bingo balls or the flashboard, and Rainbow Bingo determines the specific winning combination after, rather than before, the first bingo ban is drawn.

Planet Bingo concedes that Judge Leen's claim construction precludes a finding of literal infringement on claims 3 and 6-9 of the '289 patent because Judge Leen ruled those claims require the physical marking of bingo balls, which Rainbow Bingo undisputably does not do. However, Planet Bingo argues that Rainbow Bingo infringes the '289

patent under the doctrine of equivalents. Planet Bingo contends designating a particular column one color achieves the same thing as physically coloring all "B" balls one color. Planet Bingo also argues Rainbow Bingo infringes the '786 patent both literally and under the doctrine of equivalents because Rainbow Bingo's monitor display is a flashboard 7 or its equivalent. Additionally, Planet Bingo asserts Rainbow Bingo creates a "predetermined winning combination" because before the game starts, players know columns will be marked with colors, rows will be marked with jewels, and one diamond number will be assigned per column. Players also know the progressive jackpot amount associated with each type of winning combination before the start of each game.

II. DISCUSSION

Summary judgment is appropriate if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any" demonstrate "there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). The substantive law defines which facts are material. Anderson v. Liberty Lobby. Inc., 477 U.S. 242, 248 (1986). All justifiable inferences must be viewed in the light most favorable to the non-moving party. County of Tuolumne v. Sonora Cmty. Hosp., 236 F.3d 1148, 1154 (9th Cir. 2001).

The party moving for summary judgment bears the initial burden of showing the absence of a genuine issue of material fact. Fairbank v. Wunderman Cato Johnson, 212 F.3d 528,531 (9th Cir. 2000). The burden then shifts to the non-moving party to go beyond the pleadings and set forth specific facts demonstrating there is a genuine issue for trial. Id.; Far Out Prods .. Inc. v. Oskar, 247 F.3d 986, 997 (9th

Cir. 2001).

Determining whether a product infringes a patent is a two-step inquiry. Desper Prods. v. Qsound Lab., 157 F.3d 1325, 1332 (Fed. Cir. 1998). First, the court construes the claim to determine its meaning and scope. Id. (citing Markman v. Westview Instruments. Inc., 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996)). After claim construction, the court compares the construed claims with the accused method. Desper, 52 F.3d at 1332 (citing Markman 52 F.3d at 976). The accused method may infringe a patent claim either literally or under the doctrine of equivalents. Bayer AG v. Elan Pharm. Research Corp., 212 F.3d 1241, 1247 (Fed. Cir. 2000). Literal infringement requires proof that the accused method contains each limitation of the asserted claim.[1] Id. If any limitation is absent from the accused devise, there is no literal infringement as a matter of law. Id.

A method that does not literally infringe a patent claim still may infringe under the doctrine of equivalents if the accused product contains "elements identical to or equivalent to each claimed [limitation] of the patented invention."[2] Warner-Jenkinson Co.Inc. v. Hilton Davis

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[1] The Federal Circuit has stated that "it is preferable to use the term `limitation' when referring to claim language and the term 'element' when referring to the accused device." Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558, 564 n.1 (Fed. Cir. 2000) (en bane).

[2] Planet Bingo concedes the claim construction order is new law that makes reconsideration of GameTech's prior summary judgment motions for literal infringement appropriate. (Pl. Planet Bingo, LLC's Opp'n to GameTech Int'l Inc.'s Mot. in Limine to Exclude Evld. of U.S. Patent Nos. 4,482,289 and 5,727,786 (#1) (Doc. #322) at 2, 12.) But Planet Bingo argues the Court should not reconsider Judge Mahan's ruling that genuine issues of fact remain on the doctrine of equivalents analysis because the Markman ruling did not affect the equivalents issues in this case. a_d. at 12.) "Determination of infringement under the

Chem. Co., 520 U.S. 17, 40 (1997). This doctrine is based on the idea that the "'form or proportions'" of the patented item may be varied and yet still be covered under the patent. Id. at 35 (quoting Winans v. Denmead, 56 U.S. 330 (1854)).

"A claim element is equivalently present in an accused device if only 'insubstantial differences' distinguish the missing claim element from the corresponding aspects of the accused device." Riles v. Shell Exploration and Prod. Co., 298 F.3d 1302, 3 1309 (Fed. Cir. 2002) (quotation omitted). "How equivalency to a required limitation is met necessarily varies from case to case due to many variables such as the form of the claim, the nature of the invention defined by it, the kind of limitation that is not literally met, etc." Malta v. Schulmerich Carillons. Inc., 952 F.2d 1320, 1326 (Fed. Cir. 1991). "Because infringement under the doctrine of equivalents often presents difficult factual determinations, a summary conclusion that a reasonable jury could not find infringement is often [elusive]." Leggett & Platt. Inc. v. Hickory Springs Mfg. Co., 285 F.3d 1353, 1360 (Fed. Cir. 2002).

The patentee bears the burden of proving the accused method meets each claim limitation. Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092 (Fed. Cir. 1997). Summary judgment on infringement is proper "only when there is no genuine issue of material fact as to whether correctly interpreted claims read upon the accused device or

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doctrine of equivalents occurs after the claims have been construed as a matter oflaw." Multiform Desiccants. Inc. v. Medzam. Ltd., 133 F .3d 1473, 1480 (Fed. Cir. 1998). Claim construction affects the Court's analysis under the doctrine of equivalents because until a claim is construed properly, the Court cannot determine what elements in the accused device may be equivalent to claim limitations. Reconsideration on a summary judgment standard therefore is appropriate for GameTech's motion on both literal and equivalent infringement.

method, literally or under the doctrine of equivalents." Lifescan. Inc. v. Home Diagnostics. In_c., 76 F.3d 358,359 (Fed. Cir. 1996).

Planet Bingo contends Rainbow Bingo infringes claims 3 and 6-9 of the '289 patent.[3] The parties do not dispute that Rainbow Bingo practices every limitation in these 19 claims except for two: (1) marking the bingo balls with indicium and (2) establishing a predetermined winning combination. Additionally, Planet Bingo contends Rainbow Bingo infringes claims 1,4, 7, 8, 11, 12, 15, 16, 19, 21, 24, 25, 28, 32, and 35-39 of the '786 patent. The parties do not dispute that Rainbow Bingo practices every limitation in these claims except for two: (1) designating portions of the electronic number reader bingo board with markings and (2) establishing a predetermined winning combination.

A. Literal Infringement

I. Marking the Bingo Balls in the '289 Patent

Claims 3 and 6-9 of the '289 patent contain the limitation that the "bingo balls are marked" with indicium. (Non-Confidential Pennypacker Decl., Ex. 4 at GTI001292-93.) Judge Leen construed these terms to mean "physically applying a differentiating characteristic to the physical bingo balls." (Non-Confidential Pennypacker Decl., Ex. 1 at 9.)

It is undisputed that Rainbow Bingo would not physically mark the bingo balls. Planet Bingo concedes

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[3] Planet Bingo also alleges Rainbow Bingo infringes on claims 2 and 5 of the '289 patent. 25 Those claims are the subject of a separate motion in limine filed by Game Tech. (Defs. Mot. in Limine to Exclude Evld. Regarding Claims 2 and 5 of U.S. Patent No. 5,482,289 (#2) (Doc. #296).) The Court 26 will address those claims in a separate order.

Rainbow Bingo does not literally infringe on this claim limitation. (Pl. Planet Bingo, LLC's Opp'n to GameTech Int'l Inc.'s Mot. in Limine to Exclude Evld. *Of U.S.* Patent Nos. 4,482,289 and 5,727,786 (#1) (Doc. #322), at 13.) The Court therefore will grant GameTech's motion for summary judgment for literal non-infringement on claims 3 and 6-9 of the '289 patent.

2. Predetermined Winning Combination in the '289 and '786 Patents

Claims 3 and 6-9 of the '289 patent and every claim at issue in the '786 patent contain the limitation of a "predetermined winning combination." (Non-Confidential Pennypacker Decl., Ex. 4 at GTI00I292-93, Ex. 6 at GTI001308-11.) Judge Leen construed this term to mean:

> the precise elements necessary to achieve a "bingo" in a particular game determined before the first bingo ball is drawn. "The precise elements necessary to achieve a 'bingo' in a particular bingo game" are (a) at a minimum, a combination of one or more spaces on a bingo card matrix which, when covered by a player represent a bingo win; together with (b) other necessary predetermined winning criteria if any.

(Non-Confidential Pennypacker Decl., Ex. 1 at 8, 13.)

GameTech argues Rainbow Bingo cannot infringe this limitation either literally or under the doctrine of equivalents, because it does not establish winning combinations until after the first bingo ball is drawn, and thus its winning combinations are not predetermined. Further, GameTech contends Weingardt surrendered any claim to patent 4 protection for designations made to the flashboard after the first ball is drawn because the patent

examiner on Weingardt's '786 patent mentioned the limitation that designations would be made before the first ball was drawn in the Reasons for Allowance. GameTech argues Weingardt should not be able to recapture through the doctrine of equivalents what he surrendered during patent prosecution.

Planet Bingo responds that Rainbow Bingo literally infringes on this limitation because it also has predetermined winning combinations. Planet Bingo notes that before the first ball is drawn, Rainbow Bingo players would know the progressive prize amount for each colored bingo. They would know that five columns will be colored: three columns will be blue, one will be purple, and the middle "N" column will be either pink or orange. Additionally, players would know each column will have one diamond number. The players also would know there will be six row progressive jackpots: two will be ruby, three will be emerald, and the last one will be either silver or gold. Planet Bingo also argues that even if Rainbow Bingo does not literally infringe this limitation, it does so under the doctrine of equivalents. Planet Bingo argues that the timing of making the designations does not alter the odds or otherwise affect bingo game play, and that it is an insubstantial distinction GameTech has employed as an obvious attempt to copy and circumvent the Weingardt patents. Planet Bingo contends that Weingardt had no duty to respond to the patent examiner's Reasons for Allowance on the '786 patent, and he is not barred from arguing insubstantial differences between making designations before or after the first ball is drawn.

Rainbow Bingo does not literally infringe on this claim limitation as a matter of law. Although Rainbow Bingo players would know some pre-determined aspects before the start of a Rainbow Bingo game, players will not know the "combination of one or more spaces on a bingo card matrix

which, when covered by a player represent a bingo win; together with (b) other necessary predetermined winning criteria, if any." Rainbow Bingo players would not know until after the first ball is drawn which columns specifically have been designated as blue, purple, pink or orange; what numbers are diamond numbers; or which rows are ruby, emerald, silver or gold. Thus, a player would not know the precise elements necessary to achieve, for example, a blue bingo until after the first ball is drawn. Accordingly, the Court will grant GameTech's motion for summary judgment on literal non-infringement of claims 3 and 6-9 of the '289 and claims 1, 4, 7, 8, 11, 12, 15, 16, 19, 21, 24, 25, 28, 32, and 35-39 of the '786 patent.

B. Infringement Under the Doctrine of Equivalents

The doctrine of equivalents "is designed to avoid 'a fraud on a patent' by discouraging 'the unscrupulous copyist [from] mak[ing] unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.'" Int'l Visual Corp. v. Crown Metal Mfg. Co . Inc., 991 F.2d 768, 773-74 (Fed. Cir. 1993) (Lourie, J. concurring) (quoting Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 607-08 (1950». The doctrine of equivalents balances the competing policies of fairness to inventors and fair notice to the public of the clear boundaries of a patent scope's claims. Broad application of the doctrine of equivalents '" conflicts with the definitional and public-notice functions of the statutory claiming requirement.'" Ethicon Endo-Surgery. Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1316 (Fed. Cir. 1998) (quoting Warner-Jenkinson, 520 U.S. at 29). On the other hand, a narrow application of the rule would reduce the doctrine "to nothing more than a repeated analysis of literal

infringement" because once a court found no literal infringement, the failure to meet a limitation would preclude a finding of infringement under the doctrine. Id. at 1317. The doctrine of equivalents "necessarily deals with subject matter that is 'beyond,' 'ignored' by, and not included in the literal scope of a claim." Id. (emphasis omitted).

To balance these competing concerns, the doctrine of equivalents is limited by two other doctrines: (1) prosecution history estoppel and (2) the "all elements" rule. See Bell Atl. Network Servs .. Inc. v. Covad Communications Group. Inc., 262 F.3d 1258, 1267 (Fed. Cir. 2001). "The doctrine of prosecution history estoppel bars a patentee from asserting as an equivalent subject matter surrendered during prosecution of the patent application." Eagle Comtronics. Inc. v. Arrow Communication Laboratories. Inc., 305 F.3d 1303, 1316 (Fed. Cir. 2002). Under the "all elements rule," an accused method does not infringe under the doctrine of equivalents "if even one element of a claim or its equivalent is not present in the accused device." Bell Atlantic, 262 F.3d at 1279. The doctrine of equivalents must be applied to each individual element of a claim, and not to the invention as a whole. Warner-Jenkinson, 520 U.S. at 29. In making this comparison, a court should not allow the doctrine "such broad play as to effectively eliminate that element in its entirety." Id.

The Federal Circuit has articulated this concept in various ways. In Cooper Cameron Cor:p. v. Kvaemer Oilfield Prods .. Inc., 291 F.3d 1317, 1322 (Fed. Cir. 2002), the Court indicated the doctrine cannot be used to "vitiate" a patent limitation. In another case, the Court stated that "equivalency cannot embrace a structure that is specifically excluded from the scope of the claims." Athletic Alternatives. Inc. v. Prince Mfg .. Inc., 73 F.3d 1573, 1582 (Fed. Cir. 1996) (quotation omitted). But the Court clarified

that "subject matter is not necessarily 'specifically excluded' from coverage under the doctrine unless its inclusion is somehow inconsistent with the language of the claim. Literal failure to meet a claim limitation does not necessarily amount to 'specific exclusion.'" Ethicon, 149 F.3d at 1317. In Ethicon, the Court considered whether there was "a subtle difference in degree" as opposed to a "clear, substantial difference or difference in kind." Id. at 1321.

In addition to varying articulations of the standards, the Federal Circuit's application of those standards has led to some results that could be viewed as inconsistent. Two lines of cases have developed that either broadly or narrowly apply the doctrine of equivalents.

In a series of cases, the Federal Circuit has construed narrowly the doctrine's application. For example, in Moore U.S.A .. Inc. v. Standard Register Co., 229 F.3d 1091 (Fed. Cir. 2000), the patentee claimed strips of adhesive that extend a "majority of the lengths" of the longitudinal margins, but the allegedly infringing products extended only a minority of the length of the longitudinal margins. The Court held a minority was not the equivalent of the claim term "majority" for two reasons. Id. at 1106. First, the Court concluded that to allow a minority to be equivalent to a majority would vitiate the majority requirement. Id. Second, the Court stated "it would defy logic to conclude that a minority--the very antithesis of a majority--could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise." Id.

Likewise, in Cooper Cameron Corp., 291 F 3d at 1319, the claim limitation at issue required a wellhead assembly to be "between ... two plugs." The allegedly infringing device included a wellhead assembly "above" two plugs. The Federal Circuit affirmed a grant of summary

judgment, finding that the allegedly infringing device's assembly above the plugs could not be the equivalent of the claim language between the plugs. Id. at 1322.

In the recent case of Asyst Technologies. Inc. v. Emtrak. Inc., --- F.3d ---,2005 WL 646849, *6 (Fed. Cir. Mar. 22, 2005), the patentee claimed a "mounted" microcomputer. The Federal Circuit affirmed the district court's summary judgment ruling that an "unmounted" microcomputer could not be the equivalent of the patent claim's "mounted" microcomputer "without vitiating the 'mounted on' limitation altogether." Id.

Similarly, in Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420 (Fed Cir. 1997), the patent claimed a system for safely disposing of sharp medical instruments. The patent described the disposal container as having an elongated slot at the top of the container body with a first constriction extending over the slot. Id. at 1422. The accused device had an elongated slot within the container body rather than to at the top of the container body. Id. at 1423. The Federal Circuit held the patent language contained clear structural limitations that it would not "effectively remove" through the doctrine of equivalents. Id. at 1425-26.

In other cases, however, the Federal Circuit has applied the doctrine of equivalents more broadly. In Wright Med. Tech .. Inc. v. Osteonics Corp., 122 F.3d 1440 (Fed. Cir. 1997), the patentee claimed a "rod portion adapted to closely fit in and extend through" a portion of a human femur. The district court interpreted this claim language to require a rod that fit tightly into and extended all the way through the femur. Id. at 1444. The accused rod did not extend all the way through the femur. Id. The district court granted summary judgment on both literal and equivalent infringement. Id. at 1442. The Federal Circuit affirmed as to

literal infringement, but reversed with respect to the doctrine of equivalents. Id. at 144-45. The Court found that a reasonable jury could find that the claim language "extend through" could be infringed under the doctrine of equivalents by a device with a rod that clearly did not extend through the femur. Id. at 1446. The Federal Circuit noted that both the claimed invention and the accused device employed a rod element, and that a finding of equivalence would not entirely vitiate a particular claim element. Id. at 1445.

In Ethicon, 149 F.3d at 1313, the patentee claimed a restraining structure that contacted a barrier "during staple firing." The allegedly infringing product used a restraint that lost contact with the barrier just prior to the staple firing stroke. Id. at 1321. The Federal Circuit reversed the lower court's finding of no infringement under the doctrine of equivalents. Id. at 1320-21. The Federal Circuit noted that only a few millimeters in length and a few thousandths of a second distinguished the accused device from the patent claim. Id. at 1321. The Court found that in light of the slight difference in length and time, a question of fact remained as to whether the accused device infringed under the doctrine of equivalents. Id.

The construed claim limitation of a "predetermined winning combination" in this case requires that the winning combination be determined before the first bingo ball is drawn. Rainbow Bingo does not determine the winning combination until after the first bingo ball is drawn. Under the Moore line of cases narrowly construing the doctrine of equivalents, summary judgment would be appropriate because "after" is the very antithesis of "before," and cannot be its equivalent as a matter of law. Alternatively, under the Wrigln and Ethicon cases giving the doctrine broader scope, summary judgment would be inappropriate because the slight difference in timing between before and after the first

bingo ball is drawn raises a genuine issue of fact on equivalency.

The Court concludes the Moore, Cooper, Asyst, and Sage Prods. line of cases are more analogous to the instant case. The '289 and '786 patent claims require a predetermined winning combination, which was construed to mean before the first bingo ball is drawn. After is the opposite of before, not its equivalent. Thus, a game method such as Rainbow Bingo in which the winning combination is determined after the first bingo ball is drawn cannot be the equivalent of the predetermined limitation a matter of law. To allow equivalency would vitiate the "predetermined" limitation, and would be inconsistent with the patent claim language. Although Planet Bingo argues this analysis collapses the literal and equivalent infringement analyses and renders the doctrine of equivalents superfluous, the Federal Circuit has recognized that "many limitations warrant little, if any, range of equivalents." Moore, 229 F.3d at 1106.

When faced with the tension between the doctrine of equivalents and fair notice to the public, courts ought to err on the side of fair notice to the public. As explained by the Federal Circuit in Sage Products:

> If Sage desired broad patent protection for [its design], it could have sought claims with fewer structural encumbrances. Had Sage done so, then the Patent and Trademark Office (PTO) could have fulfilled its statutory role in helping to ensure that exclusive rights issue only to those who have, in fact, contributed something new, useful, and unobvious. Instead, Sage left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents. However, as between the patentee who had a clear opportunity to negotiate

> broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.
>
> •

Sage Products, 126 F 3d at 1425. Although this "places a premium on forethought in patent drafting," broadly interpreting the doctrine of equivalents would "create[] a zone of uncertainty, into which competitors tread only at their peril." Id.

Weingardt could have phrased his claims to include a game method where the winning combination is determined before and after the first ball is drawn if he wanted broader protection for his game method. As between Weingardt and the public, Weingardt was in a position to control the scope and meaning of his patent claims, and he should bear the burden of any failure to do so. Accordingly, the Court will grant GameTech's motion for summary judgment for non-infringement under the doctrine of equivalents for claims 3 and 6-9 of the '289 patent, and claims 1,4, 7, 8, 11, 12, 15, 16, 19, 21, 24, 25, 28, 32, and 35-39 of the '786 patent.

III. CONCLUSION

IT IS THEREFORE ORDERED that Defendants' Motion in Limine to Exclude Evidence of All Infringement of U.S. Patent Nos. 5,482,289 and 5,727,786 (#1) (Doc. #292) is hereby GRANTED. Rainbow Bingo does not infringe as a matter of law claims 3 22 and 6-9 of the '289 patent, or claims 1, 4, 7, 8, 11, 12, 15, 16, 19, 21, 24, 25, 28, 32, and 35- 39 of the '786 patent literally or under the doctrine of equivalents.

DATED: April 18, 2005

PHILIP M PRO
Chief United States District Judge

NOTE: This order is nonprecedential.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellants, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 29, 2007.

FOR THE COURT,

Jan Horbaly
Clerk

Dated: 01/22/2007

cc: Jeffrey Weiss
Claude M. Stern
PLANET BINGO V. GAMETECH INTERNTL, 2005-1476
(DCT-01-CV-1295)

(2)

No. 06-1397

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IN THE

Supreme Court of the United States

PLANET BINGO, LLC AND GARY WEINGARDT,
Petitioners,

v.

GAMETECH INTERNATIONAL, INC., RICHARD FEDOR, GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENTS' BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether the Federal Circuit erred when it found no infringement under the doctrine of equivalents as a matter of law on the grounds that determining the winning combination in bingo "before" the game begins—as dictated by the express language of the patents' claims, the specification, the file history, and the extrinsic evidence—is not equivalent to determining the winning combination "after" the game begins.

2. Whether the issue of infringement under the doctrine of equivalents is always a jury determination and never for the Court, as long as the patentee offers an expert report on the issue of equivalents.

RULE 29.6 STATEMENT

GameTech International, Inc. has no parent corporation, and no publicly held company owns 10 percent or more of its stock.

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IN THE

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No. 06-1397

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GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

Respondents GameTech International, Inc., Richard Fedor, Gary Held, and Graham Leonard (collectively, "GameTech") respectfully submit this brief in opposition to the petition for a writ of certiorari in this case.

INTRODUCTION

Petitioners contend that the decision below warrants review because it flouts the decisions of this Court. In fact, the decision below applies a central principle of this Court's teachings on the doctrine of equivalents: "[T]hat the application of the doctrine, even as to an individual element, is

not allowed such broad play as to effectively eliminate that element in its entirety." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997). Far from contradicting this principle, the Federal Circuit's application of the doctrine of equivalents in this case faithfully adheres to it. Petitioners' assertion of a conflict within the Federal Circuit over application of the doctrine of equivalents is similarly unfounded. In addition to the legal reasons for denying the petition, factually, this case would make a poor vehicle for reconsidering the doctrine of equivalents because of the unusual nature of the allegations and the record developed below. The Court should deny the petition.

COUNTERSTATEMENT

This case concerns various methods for adding a progressive jackpot element to a conventional bingo game. A conventional bingo game involves bingo cards, bingo balls, a hopper or blower, and a flashboard (the electronic board that tells players which bingo balls have been called in a bingo game). Pet. App. 18a. The players have one or more bingo cards with a matrix of rows and columns. Pet. App. 19a. Usually the columns are labeled B, I, N, G, and O, and numbers are divided among the rows so that each space has a unique letter and number. *Id.* Before the game begins, a winning combination, such as a row, column, diagonal or some other pattern on the player's bingo card, is determined. *Id.* Then, the bingo balls are mixed in the hopper or blower and randomly selected one at a time. *Id.* As numbers on the bingo balls are announced, players mark spaces on their bingo cards corresponding to the selected ball until a player gets the winning combination and announces "Bingo!" *Id.*

Planet Bingo markets a variation on the conventional bingo game called MP Bingo.[1] MP Bingo attempts to introduce a progressive jackpot element by adding colors to the bingo flashboard. J.A. 1616-18. Before the start of each bingo game, MP Bingo determines a winning combination, such as a row, column, diagonal or some other pattern on the player's bingo card, and adds colors to the bingo flashboard. *Id.* Players play bingo in the above described conventional method. *Id.* When a player achieves the predetermined pattern, the amount of the player's jackpot is dictated by the color of the player's bingo. *Id.* Thus, for example, a "red" bingo will have a different jackpot prize than a "yellow" bingo. *Id.* MP Bingo is progressive: If a player does not win a "red" bingo in a particular bingo game, the prize will carry over to the next game. *Id.*

In late 2001, GameTech began developing a concept for its own progressive bingo game, which it called Rainbow Bingo. Pet. App. 20a. In this game concept, the winning combination would not be determined before each bingo game begins, and it would not involve application of colors to the bingo flashboard. *Id.* Instead, after the first ball is drawn, each column in the bingo card would randomly be assigned a color, each row would randomly be assigned a jewel or coin symbol, and one diamond number would be randomly selected in each column. *Id.* Then, prizes would be awarded for bingos in a particular colored column. Other prizes would be awarded based on the presence of a jewel or a coin on a

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[1] Normally, in a patent case, the similarity between the asserted claims and the patentee's own products is irrelevant. GameTech presents this limited discussion of Planet Bingo's product because, as will be shown, Planet Bingos' expert made a variety of methodological errors, including comparing GameTech's Rainbow Bingo concept against Planet Bingo's MP Bingo game, not the '289 or '786 patents. MP Bingo also reflects how Planet Bingo itself "predetermines" (*i.e.*, determines before the game begins) a winning combination.

player's card. Pet. App. 21a. Prizes would progress from game to game until won. *Id.*

GameTech tested the waters for Rainbow Bingo by producing a demo tape, handing out some brochures and talking to potential customers. This game concept was, however, never developed into an actual working product. As a consequence, Rainbow Bingo was never made, used, played, wagered-on, or sold. Pet. App. 20a. Nevertheless, shortly after learning of GameTech's research, Planet Bingo and the inventor of the asserted patents, Gary Weingardt (hereinafter collectively "Planet Bingo"), brought this action, asserting GameTech had infringed U.S. Patent No. 5,482,289 ("'289 patent") and U.S. Patent No. 5,727,786 ("'786 patent"), of which Planet Bingo was a licensee, by "offering for sale" the Rainbow Bingo game concept.

Both of the patents asserted by Planet Bingo are directed to methods of adding a second, progressive jackpot to the conventional bingo game. The '786 patent contains claims disclosing a method of designating spaces on the flashboard with colors or other markings to create the second progressive jackpot. Pet. App. 20a. The '289 patent contains claims disclosing methods of adding "indicia" (colors, patterns or other markings) to the bingo balls to create this second progressive jackpot. Pet. App. 19a-20a.[2]

Each asserted claim in both patents requires that the "winning combination" associated with the bingo balls or flashboard containing these indicia be "predetermined." J.A. 105-07, 122-25. Gary Weingardt, the sole named inventor on the '289 and '786 patents, testified that he understood the

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[2] The '289 patent also contains claims for bingo games with a second progressive jackpot that do not require the application of indicia. Although these claims were asserted below, they were found invalid due to anticipation by prior art. Pet. App. 13a-15a. Planet Bingo has not sought review of this determination here.

term "predetermined winning combination" to mean a winning combination determined before the game begins. J.A. 1701. According to Mr. Weingardt, "[y]ou determine the combination before the game. And when they achieve it, it's after the game." *Id.*

The prosecuting attorney for both patents testified that knowing which particular combination of numbers and colors or other markings a player must achieve to win the progressive jackpot before the bingo game begins was "an important distinguishing feature" of Mr. Weingardt's invention. J.A. 1663. In the prosecution of a related European application, the prosecuting attorney emphasized the importance of this timing: "The essence of Mr. Weingardt's invention is to randomly designate *prior to the start of the bingo game* some of the bingo numbers with a first designated marking and designating the remaining bingo numbers with a second designated marking," and that this was "very much different than" the prior art. J.A. 3362, 3364 (emphasis in original).

The specifications for both patents reflect the understanding of the inventor and the prosecuting attorney. Both repeatedly explain that the winning combination must be determined and disclosed before the first bingo ball is drawn. Pet. App. 8a. For example, the specification for the '289 patent states that the operator of the bingo game "will designate at the beginning of the game which particular combination or combination of spots will be winning combinations for that particular game." *Id.* The specification for the '786 patent contains a nearly identical statement, *id.*, and it goes on to observe that "[p]rior to each game, some of the numbers on the display board are specifically designated" with distinctive markings and that "[e]ach player can then see at the beginning of a game which of the bingo numbers have the various distinctions." Pet. App. 8a-9a.

Prior to claim construction, the parties each moved for summary judgment on non-infringement and invalidity. The

district court denied both parties' motions and ordered a *Markman* hearing. This hearing was conducted before a magistrate judge, who found that a "predetermined winning combination" means that "the precise elements necessary to achieve a 'bingo' in a particular game [be] determined *before* the first bingo ball is drawn." J.A. 13, 16 (emphasis added). Over Planet Bingo's objections, the district court adopted the magistrate judge's construction. J.A. 17-18.

In light of this claim construction, GameTech filed several case dispositive motions *in limine*, including a motion to exclude all evidence of infringement based on the claim construction.[3] The district court granted GameTech's motion on April 18, 2005.

The district court held that the Rainbow Bingo game concept did not literally infringe the asserted '289 patent claims because "[i]t is undisputed that Rainbow Bingo would not physically mark the bingo balls." Pet. App., 27a. The district court also found that the Rainbow Bingo game concept could not literally infringe the asserted claims in either the '289 or '786 patents because in the Rainbow Bingo game concept, the winning combination is not determined

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[3] GameTech also moved for summary judgment on alternative grounds, including (a) there was no evidence that Rainbow Bingo had ever been "offered for sale" by GameTech—and, in particular, no evidence that GameTech had communicated to any potential customer any price associated with any version of Rainbow Bingo—and therefore no basis to claim infringement, and (b) because the claims at issue in this case are purely "method" claims, and because method claims can only be infringed by practicing the methods, not by "offering for sale" an apparatus—much less the concept of such an apparatus—that allegedly practices the methods, GameTech could not, as a matter of law, have infringed any of the claims of the '289 or '786 patents. *See Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1374 (Fed. Cir. 1991), *cert. denied* 506 U.S. 817 (1992); *Joy Technologies, Inc. v. Flakt, Inc.*, 6 F.3d 770, 775 (Fed. Cir. 1993). Neither the district court nor the court of appeals reached these arguments.

until after the game begins and therefore does not include a "predetermined winning combination" as required by the asserted claims. Pet. App., 29a-30a.

In opposition to GameTech's motion, Planet Bingo submitted a report from its expert, Susan Barrick. With respect to infringement under the doctrine of equivalents, Ms. Barrick stated that she did "not believe there is a 'bingo' reason to wait until one ball is called before making color, jewel, and diamond assignments." J.A. 818. Ms. Barrick further stated conclusorily that she believed the approaches in the asserted claims and the Rainbow Bingo game concept "are substantially the same, that they accomplish substantially the same result and that they do so in substantially the same manner." J.A. 820. In response to a separate motion filed by GameTech, the district court excluded Ms. Barrick from testifying on the issue of infringement on the grounds that she did not have sufficient expertise and had improperly compared the Rainbow Bingo game concept to Planet Bingo's MP Bingo game instead of the asserted patent claims. J.A. 77.

The district court also rejected Planet Bingo's claim of infringement under the doctrine of equivalents. While "slight" in an abstract/temporal sense, the district court found the difference in when the winning combination is determined substantial in the context of the patents asserted by Planet Bingo, because those patents require determination of the winning combination before the game begins. Pet. App. 34a. As the district court observed: "'After' is the very antithesis of 'before,' and cannot be its equivalent as a matter of law." *Id.* The district court also recognized: "[Mr.] Weingardt could have phrased his claims to include a game method where the winning combination is determined before and after the first ball is drawn if he wanted broader protection for his game method." Pet. App. 36a.

The Federal Circuit affirmed the district court. It held that there was no literal infringement because, among other

things, the asserted claims require determination of the combination needed to win the progressive jackpot before the bingo game begins, not afterwards as in the Rainbow Bingo game concept.[4] Pet. App. 5a-10a. Although Planet Bingo acknowledged that the asserted claims require the winning combination to be fixed before the bingo game begins, it argued that it was enough if the participants know the rules beforehand. Pet. App. 7a. The Federal Circuit rejected this argument because the patent claims require a "predetermined winning combination, not a pre-determined rule." *Id.* The Federal Circuit found this conclusion clearly confirmed by the patent specifications which "repeatedly . . . explain[] that the game determines the 'winning combination' before the first bingo ball is drawn." Pet. App. 8a.

The Federal Circuit also held that there was no infringement under the doctrine of equivalents, rejecting Planet Bingo's argument that determining the winning combination right after the game begins rather than before is an "insubstantial variation." Pet. App. 10a. The Federal Circuit recognized that under this Court's discussion in *Warner-Jenkinson* the doctrine of equivalents cannot be used to eliminate a claim element entirely. Pet. App. 11a. Because the requirement of a "pre-determined winning combination" is a "distinct limitation, which was part of the bargain when the patent was issued," the Federal Circuit concluded that it could not overlook the limitation or apply the doctrine of equivalents beyond its purpose so as "to allow recapture of subject matter excluded by a deliberate and foreseeable claim drafting decision." *Id.* Accordingly, the Federal Circuit rejected Planet Bingo's doctrine of equivalents claim as a matter of law. Pet. App. 11a-13a.

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[4] Planet Bingo has not contested the district court's determination that there was no literal infringement of the '289 because the Rainbow Bingo concept never contemplated marking bingo balls.

The Federal Circuit denied Planet Bingo's subsequent petition for rehearing without dissent or request for response. Pet. App. 38a.

REASONS FOR DENYING THE PETITION

I. THE FEDERAL CIRCUIT'S APPLICATION OF THE DOCTRINE OF EQUIVALENTS DOES NOT WARRANT THIS COURT'S REVIEW.

Petitioners contend that the Federal Circuit has developed "a 'vitiation doctrine' and a confusing and irreconcilable jurisprudence." Pet. 14. According to petitioners, this "vitiation doctrine" takes a "rigid, linguistic approach in which the judge determines whether a claim term in the element for which equivalents is alleged has an antonym, or is otherwise particularly specific." *Id.* In fact, the Federal Circuit has not applied a rigid, linguistic test to the doctrine of equivalents analysis, much less created an irreconcilable jurisprudence. To the contrary, it has faithfully applied the principles announced by this Court to the specific facts of the cases before it. Moreover, it properly applied the doctrine of equivalents to this case. Certiorari should be denied.

A. The Federal Circuit's Application of the Doctrine of Equivalents Does Not Conflict with the Decisions of this Court.

According to petitioners' alarmist characterization, the Federal Circuit has "seiz[ed] on a single word in a footnote" in this Court's opinion in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), Pet. 2, and constructed out of that footnote a "vitiation" doctrine, Pet. 3, which applies a "rigid, linguistic approach" that subverts the doctrine of equivalents by making its application turn upon the "happenstance of word choice." Pet. 14, 26. This is simply not true. As the decision below demonstrates, the Federal Circuit has been faithfully applying the principles announced by this Court in *Warner-Jenkinson*.

The principle that the doctrine of equivalents cannot be used to vitiate any element of a claim is not some minor exception that has been hijacked to swallow the doctrine of equivalents. It is a core component of the doctrine. In *Warner-Jenkinson*, this Court considered whether the doctrine of equivalents can be reconciled with the fundamental axiom that the scope of a patent is defined by its claim language. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996) (noting that the claim is "the portion of the patent document that defines the scope of the patentee's rights"). The Court concluded that the doctrine is consistent with the definitional function of claim language if each element of a patent claim is deemed material, and the doctrine of equivalents is applied only to "individual elements of the claim, not to the invention as a whole." *Warner-Jenkinson*, 520 U.S. at 29. In this way, the doctrine of equivalents ensures that the elements of a patent claim reach matters not literally covered by the wording of a particular claim due to the inherent infirmities of language, without expanding the intended scope of those elements. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 734 (2002) ("The doctrine of equivalents is premised on language's inability to capture the essence of innovation."). *Warner-Jenkinson* stressed, however, that, even under the doctrine of equivalents, the scope of a patent is defined by the claim language. The Court therefore cautioned that in applying the doctrine of equivalents, courts must exercise "special vigilance against allowing the concept of equivalence to eliminate completely any [individual] elements." *Warner-Jenkinson*, 520 U.S. at 40; *see also id.* at 29 ("It is important to ensure that the application of the doctrine . . . is not allowed such broad play as to effectively eliminate the element in its entirety.").

The Federal Circuit faithfully adheres to the principle that, even under the doctrine of equivalents, the scope of a patent is defined by its claim language. Applying *Warner-Jenkinson*,

the Federal Circuit has recognized an "all elements" or "all limitations" rule. This rule requires that "equivalence be assessed on a limitation-by-limitation basis" and that no finding of equivalence can be made "if such a finding would entirely vitiate the limitation" in question. *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005). Contrary to Planet Bingo's assertions, this all limitations rule is not applied in a rigid fashion that focuses blindly on word choice. Instead, it is a flexible, context-specific test:

> There is no set formula for determining whether a finding of equivalence would vitiate a claim limitation, and therefore violate the all limitations rule. Rather, courts must consider the totality of circumstances of each case and determine whether the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless.

Id. at 1359; *accord LG Electronics, Inc. v. Bizcom Electronics, Inc.*, 453 F.3d 1364, 1380 (Fed. Cir. 2006); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 850 (Fed. Cir. 2006).

Contrary to Planet Bingo's argument, the Federal Circuit's decision in *Ortho-McNeil Pharmaceutical, Inc. v. Caraco Pharmaceutical Laboratories, Ltd.*, 476 F.3d 1321 (Fed. Cir. 2007), does not suggest otherwise. Planet Bingo asserts that, by finding no genuine issue concerning application of the doctrine of equivalents to a patent for a chemical composition, *Ortho-McNeil* directly conflicts with *Warner-Jenkinson*, which according to Planet Bingo, found a genuine issue concerning application of the doctrine of equivalents to a chemical composition patent. Pet. 17. In fact, although the plaintiff in *Warner-Jenkinson* sought to apply the doctrine of equivalents to a chemical composition patent, this Court did not consider whether there was a genuine issue. Instead, it remanded that issue to the Federal Circuit, *see Warner-*

Jenkinson, 520 U.S. at 41, which found the doctrine applicable "in the context of the claimed process," *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997).

The decision below does not support Planet Bingo either. The Federal Circuit did not, as Planet Bingo asserts, refuse to apply the doctrine of equivalents based upon a rigid formula. Rather, it recognized that Planet Bingo's patent claims contain a "distinct limitation"—a winning combination that is "predetermined," that is, determined before the bingo game begins—which was included by a "deliberate and foreseeable claim drafting decision." Pet. App. 11a-12a. Planet Bingo failed, however, to explain how this limitation could be applied to winning combinations determined after the game begins without allowing Planet Bingo to capture subject matter deliberately excluded by the claim language. Accordingly, the Federal Circuit found no infringement under the doctrine of equivalents. *Id.* Far from flouting *Warner-Jenkinson*, the conclusion is a logical corollary to this Court's recognition that the doctrine of equivalents reaches matters inadvertently not covered due to the infirmities of a claim's language, not matters deliberately excluded by that language.

Planet Bingo also contends that the Federal Circuit has ignored this Court's "consistent emphasis on the concept of 'insubstantial' differences." Pet. 12 (emphasis and capitalization omitted). Quite the contrary, *Warner-Jenkinson* considered the so-called insubstantial differences test, and it noted that the test offers little guidance "as to what might render a given difference 'insubstantial.'" 520 U.S. at 39-40. More important, this Court stated that the particular formulation of the test was less significant than whether the test performs the "essential inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Id.* at 40. Planet Bingo does not—and cannot—dispute that in the decision below and

other cases Planet Bingo cites, the Federal Circuit has adhered to this inquiry.

B. There Is No Intra-Circuit Conflict over the Doctrine of Equivalents.

Planet Bingo argues that the differing outcomes in Federal Circuit doctrine of equivalents decisions reflect a conflict within the Federal Circuit over the rigid "linguistic" test formulated by the Circuit. Pet. 17-20. There is no such test and therefore no conflict over it. Rather, the supposed disarray in the Federal Circuit reported by Planet Bingo reflects the highly context-specific nature of the analysis employed, which yields differing outcomes based upon differences in claim language, specifications, prosecution histories, and other evidence.

For example, citing two cases, Planet Bingo claims that a conflict exists within the Federal Circuit over how to deal with "narrowing structural language." One case cited by Planet Bingo, *Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), concerned a patent for a container with a particular structure for disposing of medical waste. *Id.* at 1422. The plaintiff contended that a container that did not place the slot for inserting waste at the top as directed by the asserted claim nonetheless infringed under the doctrine of equivalents. Finding that the location of the slot was essential to the claim limitation, the Federal Circuit found no infringement under the doctrine of equivalents. *See id.* at 1424-25. The other case cited by Planet Bingo, *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324 (Fed. Cir. 2000), concerned a patent for a method of writing music onto CDs with lasers using a waveform with "ramped trailing edges" that produces a certain thermal profile of the "pit" in the CDs carved by the lasers. *Id.* at 1331. The allegedly infringing product used a slightly different shape for the trailing edge of the laser, "a double-step" rather than a ramp, which created the same thermal profile. *Id.* at 1335-36. Finding that the precise

shape of the waveform was not essential to the claim limitation in question, the Federal Circuit remanded for consideration of the doctrine of equivalents. *Id.* Thus, the Federal Circuit reached different conclusions about the doctrine of equivalents arguments in *Sage* and *Optical Disc* because the cases involved different types of "structural" claim limitations with different significance in the different asserted patent claims.

The supposed conflict in the Federal Circuit's treatment of chemical ranges (Pet. 19) similarly reflects differences in particular claim limitations and prosecution histories. One of the two cases cited by Planet Bingo, *Abbott Laboratories v. Dey, L.P.*, 287 F.3d 1097 (Fed. Cir. 2002), involved a patent for a composition containing seven ingredients. *See id.* at 1100. In the allegedly infringing product, the composition of one of these ingredients was from 1%-4% greater than the range specified in the patent, *see id.* at 1100 (patent specified range of 68.6-90.7% for phospholipds); *id.* at 1101 (allegedly infringing product was 91.8%- 94.5% phospholipid), and the Federal Circuit found infringement under the doctrine of equivalents. *See id.* at 1107-08. The other case, *Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Labs., Inc.*, 476 F.3d 1321, involved a patent for a composition of two drugs alleged to have "superadditive or synergistic" effects at a ratio of "about 1:5." *Id.* at 1323-24. The allegedly infringing product had a ratio of 1:7.5, which is 50% higher than the ratio specified in the patent and outside the confidence intervals demonstrating statistical significance. *See id.* at 1328; *see also id.* (finding that any ratio above 1:7.1 is statistically different from a ratio of 1:5). Because the patent pointed to confidence levels, and because the patentee withdrew broader claims that it admitted were invalid, the Federal Circuit found no infringement under the doctrine of equivalents. *See id.* at 1328-29. Thus, in *Ortho-McNeil* where the Federal Circuit found no infringement under the doctrine of equivalents, there was a much greater difference in composition than in *Abbott Labs*, where

it found such infringement, and the prosecution history established that the p[illegible]e ratio was deliberately chosen by the patentee to ensure validity.

The timing cases cited by Planet Bingo (Pet. 18-19) also reflect dispositive differences in fact. One of these cases, *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369 (Fed. Cir. 2003), concerned a patent directed to an apparatus for supplying power to a telephone set in a telecommunications system. *Id.* at 1371. The infringement determination turned on a claim limitation that required that speech amplifiers *only* supply power to the telephone set in the off-hook position. The accused apparatus had control circuitry that supplied power to the telephone set less than 0.1% of the time in the on-hook position. The Federal Circuit reversed the district court's finding of no infringement on the grounds that (a) the accused device supplied power from the control circuitry, not from the speech amplifier, as required in the claim and (b) despite the less than 0.1% of time when power might be supplied in the on-hook position, the accused device was "very close" to only supplying power to the telephone set in the off-hook position. *Id.* at 1375. The Federal Circuit reasoned that, while a device that *always* supplied power to the telephone set in the on-hook position would vitiate the claim limitation, a device that did so just 0.1% of the time would not. *Id.* at 1374-75.

The other "timing" case cited by Planet Bingo, *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309 (Fed. Cir. 1998), further demonstrates the Federal Circuit's context-specific approach to application of the doctrine of equivalents. The patent in *Ethicon* was directed to a lockout device for linear cutter staples used in surgery. *Id.* The accused stapler had a lockout bar that was located at one end of the stapler and was held in the path of the pusher assembly until just before the first staple was fired. *Id.* at 1313. The Federal Circuit found no infringement of one claim under the doctrine of equivalents because the claim language spe-

cifically required that the lockout bar be located near the longitudinal slots, and the accused stapler's lockout bar was located "nowhere near the longitudinal slots." *Id.* at 1318. Because the lockout bar in the accused stapler was "not even close"—in fact, in the "opposite" direction—to the claimed location, the Federal Circuit found the district court correctly found no infringement under the doctrine of equivalents and granted summary judgment on that claim. *Id.* at 1319. The Federal Circuit reversed summary judgment on another claim, which required a restraining structure which contacts the barrier "during staple firing." *Id.* at 1320. The evidence showed that the accused stapler lost contact with the barrier for a few thousandths of a second just before staple firing. Finding this to be "a subtle difference in degree, not a clear, substantial difference or difference in kind," the Federal Circuit found a genuine issue concerning infringement under the doctrine of equivalents. *Id.* at 1321. Thus, it was the particular claim language that dictated the result in these "timing" cases.

The final pair of cases cited by Planet Bingo, *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005 (Fed. Cir. 2006), and *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998), are similarly reconcilable. Both of these cases dealt with claim limitations relating to shapes, but there was a crucial difference in the prosecution history for the claims in these cases. In *Tronzo*, claims for a device with no specific shape were held invalid for lack of adequate disclosure in the description, *see* 156 F.3d at 1158-60, and the Federal Circuit concluded that the patentee therefore could not use the doctrine of equivalents to argue that any shape was the equivalent of the conical shape specified in the patent. *See id.* at 1160. There was no similar prosecution history in *Depuy Spine*. Thus, the different rulings in *Depuy Spine* and *Tronzo* reflect differences in the prosecution histories of the patents, not the inconsistent application of any rigid test.

As this discussion makes clear, all of the decisions cited by Planet Bingo as reflecting inconsistency in the application of the doctrine of equivalents are readily explained and reconciled by the highly context-specific nature of the analysis employed in each case. Ultimately, whether the doctrine of equivalents is applicable in some cases and not in others is dictated by case-specific aspects of the relevant claim language, specifications, prosecution histories, and other case specific evidence.

There is no merit to Planet Bingo's complaint that "[t]here is currently no reliable basis for ascertaining whether a particular claim term will support application of the Federal Circuit's 'vitiation doctrine.'" Pet. 18. This Court's decisions concerning the doctrine of equivalents mandate the application of flexible standards that turn upon the particular facts of the case, and such standards are inevitably difficult to predict, particularly when they are viewed from levels as abstract as timing, chemical composition, and structural limitations. This Court has therefore long recognized that the doctrine of equivalents necessarily creates uncertainty. *See, e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 ("In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes equivalents."). That uncertainty is, however, the "price of ensuring the appropriate incentives for innovation." *Festo*, 535 U.S. at 732. Accordingly, the fact that Planet Bingo is able to identify seeming inconsistencies in the Federal Circuit's application of the doctrine of equivalents provides no reason for reviewing this case.

C. The Decision Below Correctly Affirmed Summary Judgment of Non-Infringement Under the Doctrine of Equivalents.

Planet Bingo sued GameTech and various officers for infringing patents that, by their unambiguous terms, as con-

firmed by the claim language, patent specifications, and the admissions of the inventor and his prosecuting attorney, require that the "winning combination" for any bingo game be "*pre*determined." All parties recognized before the district court that this term means determined "before" the start of the bingo game (though they differed on what exactly needed to be determined, *see supra* p. 8). Because GameTech's accused bingo game "concept" required the winning combination to be determined *after* the beginning of the bingo game, and because the inventor deliberately chose to limit the language of his claims to winning combinations determined before the bingo game begins, the lower courts properly found that there could be no infringement of Planet Bingo's two patents, either literally or under the doctrine of equivalents.

Although Planet Bingo suggests that the claim construction in this case was ill-considered, Pet. 9, it is indisputable that the patent claims at issue in this case are limited to bingo games in which the winning combination for a progressive jackpot is determined before the game begins. Each asserted claim in both patents claims a "predetermined" winning combination, which in context clearly indicates a determination prior to the beginning of the bingo game. Pet. App. 19a-20a. Any possible doubt about this meaning of the claim language is dispelled by the specifications, prosecution history material, and the admissions of the inventor and his prosecuting counsel.

The specifications state that that the operator of the game "will designate at the beginning of the game which particular combination or combinations will be winning combinations for that particular game" and that "[p]rior to each game," numbers on the display board will be specifically designated" so that "[e]ach player can then see at the beginning of the game" the designations. Pet. App. 8a-9a. Moreover, the inventor admitted that the term "predetermined winning com-

bination" refers to a winning combination decided and disclosed before the game started. J.A. 1701; *see also Tanabe Seriyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 733 (Fed. Cir. 1997) (recognizing the relevance of inventor admissions). Thus, the "predetermined winning combination" limitation was clearly intended to require that the winning combination be determined before the bingo game begins.

The inclusion of this timing requirement was deliberate. As the district court observed, the inventor "could have phrased his claims to include a game method where the winning combination is determined before and after the first ball is drawn if he wanted broader protection for his game method." Pet. App. 36a. Instead, he chose to require a *pre*determined winning combination, which, as the specifications and his own admissions make clear, was intended to require that the winning combination be determined before the game begins. Moreover, as the inventor's prosecuting attorney admitted, this timing limitation was "an important distinguishing feature" of the alleged inventions which was included to distinguish prior art cited in a related European application. J.A. 1663; *see also Tanabe*, 109 F.3d at 733 (recognizing the relevance of representations in prosecuting foreign counterparts). Thus, there is nothing inadvertent or unexpected about the requirement that the winning combination be determined before the bingo game begins.

As the Federal Circuit recognized, such a deliberate claim drafting decision renders the doctrine of equivalents inapplicable. The doctrine is "premised on language's inability to capture the essence of innovation," *Festo*, 535 U.S. at 733, and it therefore "allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent." *Id.* at 734. It is well-settled, however, that the doctrine of equivalents cannot be used to effectively eliminate any individual elements of a claim and therefore does not allow patentees to capture or recapture subject matter that

they chose to exclude by including particular limitations in their claims. *See Warner-Jenkinson*, 520 U.S. at 30-31. Instead, this Court has held that where "a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve." *Id.* at 39 n.8. That is the case here.

Planet Bingo contends that waiting for one ball to be called before assigning indicia to the bingo card in Rainbow Bingo is a "gimmick," and that the difference between the timing of determining a winning combination in Rainbow Bingo and in the asserted claims was slight and therefore insubstantial. Pet. 8, 25-26. The deliberately included limitations in the asserted claims cannot, however, be ignored. As this Court has repeatedly recognized, "[e]quivalence . . . is not an absolute to be considered in a vacuum." *Warner-Jenkinson*, 520 U.S. at 24-25 (quoting *Graver Tank*, 339 U.S. at 609). Instead, "[w]hat constitutes equivalency must be determined *against the context of the patent*," and "[c]onsideration must be given to the purpose for which an ingredient is used in a patent." *Id.* (emphasis added and quotation omitted). Notably absent from the petition is any attempt to show that the difference between determining the winning combination before the game begins and after the game begins is insubstantial in the context of the patent.

Planet Bingo's "bingo expert" does not save it either. The expert offered no opinion on why the timing difference was insubstantial in the context of the "predetermined winning combination" limitation. Instead, the expert stated that she did "not believe that there is a *'bingo* reason' to wait until one ball is called before making certain color, jewel, and diamond assignments." J.A. 818 (emphasis added). Even if that were true—which it is not (*see* J.A. 1903, 2062, 2064-2065 (the delay was a difference designed to increase the excitement of the game))—it would be still be immaterial because it ignores

the undisputed evidence that the timing requirement was included in the asserted claims deliberately.

Nor does it make any difference that the expert opined that the Rainbow Bingo game concept and the asserted claims are "substantially the same." As this Court has repeatedly recognized, an expert's conclusory opinion cannot create a genuine issue of fact to defeat summary judgment. *See, e.g., KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1745 (2007); *Edwards v. Aguillard*, 482 U.S. 578, 595 (1987). It is not and should not be the law that summary judgment is defeated in every patent case in which an expert can be found to testify that there was infringement.

Planet Bingo protests that the decision below impermissibly expands the all elements rule by placing dispositive emphasis on a word ("before") that does not appear in the claim limitation and therefore punishes the patentee for a claim drafting decision that the inventor did not make. Pet. 20-21. Planet Bingo cannot ignore, however, that the claim limitation refers to a *pre*determined winning combination. Undisputedly, "pre" means "before." Moreover, as the lower courts found and as described above, the claim language and specifications plainly contemplate establishing the winning combination for each bingo game before each game begins, *see supra* pp. 5, 18 and the admissions of the inventor and his prosecuting attorney confirm that this timing limitation was deliberately included in the patent claims. *See supra* pp. 4-5, 19.

Finally, Planet Bingo contends that the decision below improperly seeks to extend prosecution history estoppel. According to Planet Bingo, this Court held in *Festo* that prosecution history estoppel is the only vehicle for barring application of the doctrine of equivalents based upon the particular words used in the claim. Pet. 22-23. *Festo* suggests nothing of the sort. To the contrary, as pointed out above, *see supra* p. 19, in *Festo*, this Court recognized that

the doctrine of equivalents is premised on "language's inability to capture the essence of innovation." 535 U.S. at 734; *see also id.* at 731 ("Unfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application."). Moreover, even in that situation, *Festo* did not say that the doctrine of equivalents authorizes courts to ignore language of the patent claims. Instead, it said that the scope of the patent must be understood to include not only its "literal terms" but also "equivalents" to those terms. *Id.* at 732. There is no question about the ability of language to capture the essence of the bingo game described in the asserted patent claims, nor any ambiguity about whether the limitation in question was intended to restrict the patent to winning combinations determined before the bingo game begins. Thus, far from supporting Planet Bingo's argument, *Festo* confirms that the decision below correctly affirmed no infringement under the doctrine of equivalents.

D. This Case Is a Poor Vehicle for Reconsidering the Doctrine of Equivalents.

This case is a poor vehicle for examining the doctrine of equivalents. *First*, there are independent, alternative grounds for affirming the decision below that the Federal Circuit did not reach. For example, because Rainbow Bingo has never been made, used, played, wagered-with, or sold, petitioners' claim of infringement against GameTech alleged only that Rainbow Bingo was "offered for sale." As GameTech pointed out in the courts below, there is no evidence that Rainbow Bingo has been "offered for sale." Although the lower courts did not address this issue, it is a more than adequate alternative ground for finding non-infringement.

In addition, the patent claims at issue here are purely "method" claims, which can only be infringed by practicing the methods. *See Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1374 (Fed. Cir. 1991), *cert. denied* 506 U.S. 817 (1992); *Joy Technologies, Inc. v. Flakt,*

Inc., 6 F.3d 770, 775 (Fed. Cir. 1993). It is undisputed that no one has ever played (or otherwise used) Rainbow Bingo—it is still just a game concept that has never been completed. This is also an alternative ground for non-infringement.

Second, as just noted, there is no ambiguity about the intended scope of the patent claims here: The plain language of the claims, the specifications and the admissions of the inventor and his prosecuting attorney all confirm that the asserted claims were deliberately limited to bingo games in which the winning combination is determined before the game begins. Thus, if it is ever inappropriate to apply the doctrine of equivalents to expand the scope of a claim term, it is inappropriate here.

Third, this case presents the barest and most uninformative context possible. The allegedly infringing product in this case, GameTech's Rainbow Bingo game concept, exists only on paper. As a consequence, no one knows whether actual determination of the "winning combination" in Rainbow Bingo would take place 1 second or 5 second or 30 seconds after the game begins. This case therefore lacks any concrete detail that might inform application of the doctrine of equivalents to here.

This Court should not reassess an aspect of patent law as fundamental as the doctrine of equivalents in such an unusual context. As Planet Bingo acknowledges, Pet. 16-18, the Federal Circuit periodically issues decisions concerning the doctrine of equivalents, and the losing party frequently petitions this Court for review. Accordingly, if the Court sees any need to review the Federal Circuit's application of the doctrine of equivalents, it should easily be able to find a better case in which to do so. Moreover, the Court may benefit from further development and refinement of the issues. Because there is no conflict within the Federal Circuit, this Court does not have the benefit of lower court opinions and dissents sharpening the issues. For these rea-

sons as well, Planet Bingo's request for certiorari on the first question in the petition should be denied.

II. THE DECISION BELOW DOES NOT ADDRESS THE ROLE OF JURIES IN APPLYING THE DOCTRINE OF EQUIVALENTS

The Court also should deny certiorari on the second question presented by the petition. Planet Bingo contends that this case raises a question that *Warner-Jenkinson* left unanswered: whether juries should apply the doctrine of equivalents. Pet. i, 27-29.[5] That is incorrect. Planet Bingo itself filed a motion for summary judgment on infringement, including infringement under the doctrine of equivalents. Thus, before losing on the issue, Planet Bingo believed that the facts of this case were amenable to resolution by the judge rather than a jury. Also, as petitioners recognize, *see* Pet. 9 & n.5, the district court entered summary judgment, which by definition it could only have done if there were no genuine issue for a fact finder to decide. Finally, Planet Bingo waived the jury trial issue by failing to raise it until its petition for rehearing before the Federal Circuit. This issue has not been addressed by the lower courts and is therefore not properly before the Court in this petition. *See, e.g.*, *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 148 n.2 (1970); *TRW Inc. v. Andrews*, 534 U.S. 19, 34 (2001).

In any event, Planet Bingo's contention that its doctrine of equivalents claim should have been presented to a jury is baseless. If under the facts of this case—where the plain language of the claim, the specifications, and the admissions of the inventor and his prosecuting attorney all show a deliberate and unambiguous decision to claim the determination of a winning combination before the bingo game begins, and

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[5] Planet Bingo also suggests that equitable considerations should apply to the doctrine of equivalents analysis. Pet. 29. This Court has already rejected that suggestion. *See Warner-Jenkinson*, 520 U.S. at 36.

where the patentee failed to explain how the doctrine of equivalents can be applied to a determination after the game begins without effectively eliminating the deliberate decision to so limit that claim—the plaintiff's claim must be submitted to a jury, then as a practical matter every case involving the doctrine of equivalents must go to a jury.

CONCLUSION

The petition for a writ of certiorari should be denied.

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IN THE

Supreme Court of the United States

PLANET BINGO, LLC AND GARY WEINGARDT,
Petitioners,

v.

GAMETECH INTERNATIONAL, INC., RICHARD FEDOR, GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition For Writ Of Certiorari
To The United States Court of Appeals
for the Federal Circuit

REPLY BRIEF OF PETITIONER

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1. GameTech and the Courts Below Have Entirely Collapsed the Doctrine of Equivalents and Literal Infringement Analyses

According to GameTech, a patentee who presents claim limitations loses the right to assert equivalence for anything that is outside of their literal scope. *See* Opp. 19-20 (arguing that the doctrine of equivalents "does not allow patentees to capture or recapture subject matter that they chose to exclude by including particular limitations in their claims.") However, fundamentally, "[t]he scope of a patent is not limited to is literal terms but instead embraces all equivalents to the claims described." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002). Thus, the absence of literal infringement is the beginning of the equivalence analysis – not its end.

As GameTech's reasoning lays bare, the net effect of the Federal Circuit's vitiation doctrine is to collapse literal infringement and infringement under the doctrine of equivalents. The result is that a finding of no literal infringement requires a finding of no infringement under the doctrine of equivalents, effectively eliminating the doctrine entirely. *See, e.g.,* David J.F. Gross, et al., *Claim Construction, Patent Infringement, and the Growing Importance of the Claim Vitiation Defense*, *in Patent Litigation 2005* 45, 86 (2005) ("Under claim vitiation, taken to its logical end, the doctrine of equivalents collapses into literal infringement.").

As this Court has held from its earliest decisions applying the doctrine of equivalents, the doctrine is in place to protect patent holders from "unimportant and insubstantial" substitutes or changes to the patented invention. *Festo,* 535 U.S. at 731; *see also* Pet. at 12-13. At bottom, that means that the courts below have an obligation

to determine, where a doctrine of equivalents claim is made, whether the difference between the claimed and accused elements is "insubstantial."[1] To do that, the courts must consider the evidence of record. Here, as in the majority of vitiation cases, that simply did not occur.

In trying to create the impression that the courts below relied upon a lack of Planet Bingo evidence to find no equivalence, GameTech asserts that the district court excluded [Planet Bingo expert] Ms. Barrick from testifying on infringement." Opp. 7. GameTech has mischaracterized the record – the district court did *not* exclude Ms. Barrick's testimony regarding the very issue presented by this appeal, and in fact the opposite is true.[2] Moreover, neither the district court nor the Federal Circuit purported to rely on an "exclusion" of Ms. Barrick's testimony to justify summary judgment in favor of GameTech – in fact, neither opinion contains any reference to Ms. Barrick or her testimony.

In addition, the Barrick testimony was far from the only evidence offered by Planet Bingo on equivalence. For example, Planet Bingo presented evidence that Rainbow Bingo's color and jewel winning combinations are displayed on an "attract graphic" *before* the first ball is called and,

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[1] As the Petition acknowledged (Pet. 25, n. 10), *Warner-Jenkinson* allowed flexibility in the "linguistic framework" for determining "equivalence" – i.e., "whether the substitute element plays a role substantially different from the claimed element." *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997). However, GameTech is clearly wrong when it states that the doctrine of equivalents is not focused on "insubstantial" differences. *See Festo, supra.*

[2] In a ruling separate from the one that is being challenged here, the district judge held: "Barrick is qualified and capable of testifying, for example, on the significance in bingo of the timing of marking indicia either before or after the first ball is drawn. Such testimony is relevant to the infringement inquiry." C.A.A. 3430. The only limitation that Judge Pro placed on Ms. Barrick was that he would not permit her to state the ultimate legal conclusion that Rainbow Bingo is infringing. *Id.*

indeed, that GameTech's own Rainbow Bingo patent filings call its winning combinations "predetermined" and "pre-defined." Fed. Cir. Opening Br. at 19, 55-57. The evidence presented was clearly compelling -- the district court found that Rainbow Bingo has "pre-determined aspects" and the Federal Circuit conceded that it "certainly" has a "predetermined winning combination." App. 9, 29a. Indeed, the district court stated that under one line of vitiation cases, "the slight difference in timing between before and after the first ball is drawn raises a genuine issue of fact on equivalence." App. 34-35a. GameTech ignores this.

Instead of basing their decisions on a lack of evidence, the courts below relied entirely on the linguistic finding that "after" is the antithesis of "before." *See* App. 12a ("the proposed application of the doctrine of equivalents would change `before' to `after . . ..'"); 34a ("`After' is the very antithesis of `before,' and cannot be its equivalent as a mater of law."). GameTech's attempt to infer an evidentiary analysis that did not take place reflects its discomfort in defending the *per se* vitiation rulings actually made.

Relatedly, the vitiation doctrine cannot be justified as a mere application of the "all elements" rule of *Warner-Jenkinson*, as GameTech attempts. *See* Opp. 9, 11. Given the Federal Circuit's remarkable statement that "Rainbow Bingo certainly contains a `progressive predetermined winning combination'" (App. 9a), there can be no pretense that the court below somehow found the "predetermined winning combination" element to be entirely missing in Rainbow Bingo. As shown by the decision in this case, the vitiation doctrine, "though ostensibly based on the All Elements Rule, far exceeds its mandate." Daniel H. Shulman & Donald W. Rupert, "*Vitiating*" *the Doctrine of Equivalents: A New Patent Law Doctrine*, 12 Fed. Circuit B.J. 457, 483-84 (2002-2003).

2. The Federal Circuit's Vitiation Case Law is in Internal Conflict

GameTech's argument that there is no conflict in the Federal Circuit's doctrine of equivalents decisions would come as a surprise to the district judge in this case, who specifically addressed it in his summary judgment ruling: "Two lines of cases have developed that either broadly or narrowly apply the doctrine of equivalents." App. 32a. According to the district judge, summary judgment for GameTech would be "appropriate" under one line of cases, and "inappropriate" under another. App. 34a. The Opposition fails to acknowledge or address these statements.

The cases that have narrowly applied the doctrine of equivalents, according to the district judge, included *Asyst Technologies, Inc. v. Emtrak, Inc.*, 402 F.3d 1188 (Fed. Cir. 2005); *Cooper Cameron Corp. v. Kvaerner Oilfield Products*, Inc., 291 F.3d 1317 (Fed. Cir. 2002); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091 (Fed. Cir. 2000); and *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (1997). App. 32-33a. (This is far from an exhaustive list of *per se* vitiation cases. *See* note 3, *infra*.) Planet Bingo discussed each of these in its Petition, and included a particularly lengthy treatment of the *Moore* case, including Judge Newman's dissent. Pet. 14-15. Other than *Sage*, the Opposition fails to address any of these cases that were central to the district court's opinion, and that were highlighted in the Petition. GameTech's statement that there is no intra-circuit conflict is therefore premised on a simple disregard of those cases that help establish it, and that were critical to GameTech's victory below.

Continuing in its effort to gloss over the Federal Circuit's conflicting vitiation case law, GameTech asserts

that, as applied by the Federal Circuit, the vitiation doctrine is a "flexible, content-specific test" that focuses on whether "'the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless.'" Opp. 13 (quoting *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005)). GameTech's failure to discuss *Asyst*, *Cooper*, and *Moore* – each of which exemplifies a rigid, linguistic analysis rather than a "flexible" one – deprives GameTech's statement of all credibility.

Moreover, in trying to establish that the Federal Circuit's vitiation test as applied below is consistent with the teachings of *Warner-Jenkinson*, GameTech was constrained to cite to *Freedman Seating* – a case that one commentator has described as demonstrating "the degree of confusion and unpredictability the claim vitiation doctrine creates" - rather than the decision below. *See* Robert Pribish, *Freedman Seating Co. and the Claim Vitiation Doctrine*, 43 San Diego L. Rev. 379, 396 (May-June 2006). But there is nothing in the Federal Circuit's opinion in *this* case that would lead one to believe that the vitiation doctrine is a "flexible, content-specific test," and GameTech does not even attempt to point to such language. Examples of vitiation cases where the Federal Circuit applied a *per se* vitiation rule, are legion.[3]

The fact that there are a minority of Federal Circuit cases that analyze the evidence for substantial differences – like the *Ericcson* case discussed at length at pp. 17-18 of the Petition – only proves Planet Bingo's point that the vitiation case law is "confusing and irreconcilable." Pet. 14; *see also* Shulman & Rupert, "*Vitiating*" *the Doctrine of Equivalents*,

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[3] From 2000 to 2005, the Federal Circuit applied a *per se* vitiation rule in 19 of 21 cases that considered it. Thomas C. Fiala, *Preparing and Prosecuting a Patent That Holds Up in Litigation, in Patent Litigation 2006* 515, 525 n. 17 (2006).

12 Fed. Circuit B.J. at 458 ("the Federal Circuit has either signaled an abandonment of the DOE [doctrine of equivalents], or worse, made its application unworkably uncertain"). The issue is not whether the Federal Circuit has *ever* rejected a rigid application of the vitiation doctrine in favor of a focus on whether differences are insubstantial. Rather, the problem is that some cases have engaged in such analysis, while others – like the decision below and those in *Ortho-McNeill*, *Asyst*, *Cooper*, *Moore*, *Sage*, *Tronzo*, and others (*see* Pet. 14-18 and note 3, *supra*), have done something very different. Like the district court below, the public is left to wonder which line of cases is actually consistent with the doctrine of equivalents as articulated in *Festo*, *Warner-Jenkinson* and *Graver Tank*.

3. The Vitiation Doctrine Improperly Extends Prosecution History Estoppel

GameTech's brief confirms Planet Bingo's assertion that the vitiation doctrine constitutes an improper extension of prosecution history estoppel. GameTech argues repeatedly that the patentee acted intentionally in choosing the relevant claim language. *See* Opp.19 (""The inclusion of this timing requirement was deliberate."); *id.* ("[T]here is nothing inadvertent or unexpected about the requirement that the winning combination be determined before the bingo game begins."); *see also id.* at 21, 23. The Federal Circuit's opinion below contained similar language. App. 11a.

Saying that the patentee included a claim term "deliberately" says nothing, as far as the doctrine of equivalents is concerned. Of course, if the relevant claim term was narrowed during prosecution to obtain the patent – which is not alleged to have occurred here – then prosecution history estoppel may apply. *Festo*, 535 U.S. at 737. Otherwise, however, this Court has never found that it is a

defense to the assertion of infringement under the doctrine of equivalents that claim language was "deliberately" presented by the patentee to the patent office. Instead, the doctrine of equivalents is concerned with giving the patentee the full value of its invention, recognizing "language's inability to capture the essence of innovation." *Id.* at 734.

4. This Case is an Ideal Vehicle for Curtailing the Federal Circuit's Disregard of this Court's Doctrine of Equivalents Case Law

Several points should be made in response to GameTech's argument that this case is a "poor vehicle" for examining the doctrine of equivalents. Opp. 22-24. First, Planet Bingo does not seek a fundamental re-examination of the doctrine of equivalents. This Court has already provided that, most recently in *Festo* and *Warner-Jenkinson.* The purpose instead is to ensure that the Federal Circuit is following this Court's teachings regarding the doctrine of equivalents, and not applying "a test inconsistent with [this Court's] . . . patent law decisions." *Cf. KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1743, 167 L.Ed.2d 705 (2007).

Second, this case comes at the right time. The first vitiation decision was issued in 1997. *See Sage*, 126 F.3d 1420. Over the last decade, the doctrine has had ample opportunity to grow and develop, and has done so in ways that are inconsistent and confusing to the district courts. This case exposes the fault line running through the Federal Circuit's conflicting vitiation case law. *See, supra*, 3-4.

As evidenced in the Federal Circuit's opinion below and in the other 2007 vitiation decisions, the doctrine continues to find application and, indeed, is showing signs of dramatic expansion. Following *Planet Bingo v. GameTech*, not only the inclusion of specific claim language will be

considered a "deliberate and foreseeable claim drafting decision," justifying a finding of "vitiation." Now, even words in a court-supplied interpretation of a claim term will support invocation of the doctrine, a step that essentially removes all foreseeable bounds on its application.[4] The potential applicability of vitiation to all equivalence cases has led one commentator to argue that "[i]n the years to come, it may well be that this [vitiation] doctrine will have more impact than Festo on how and when the doctrine of equivalents may be applied in patent litigation." Calvin P. Griffith, *The Law, Technology & the Arts Symposium: The Past, Present and Future of the Federal Circuit*, 54 Case W. L. Rev. 851, 855 (2004). If unchecked by this Court, the vitiation doctrine will effectively "overrule" *Warner-Jenkinson*. *See, e.g.*, Pribish, *Freedman Seating Co.*, 43 San Diego L. Rev. at 396 ("The available [vitiation] theories are simply too broad, and without restraint could lead to the vitiation of the doctrine of equivalents itself.")

Another reason why this case is ideally suited for a consideration of the vitiation doctrine is that the disputed claim element – a "predetermined winning combination" – is, according to the Federal Circuit's own opinion, "certainly" present in the accused game. App. 9a. It is doubtful that this Court will again find such a clear admission that the vitiation doctrine has nothing to do with the "all elements" rule, despite the Federal Circuit's purported reliance on *Warner-Jenkinson*.[5]

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[4] GameTech tries to suggest that the word "before" is actually in the claims, arguing that the "pre" in "predetermined" "means 'before.'" Opp. 21. GameTech is again engaged in a re-writing of the opinions below, which did not base their holdings on a linguistic deconstruction of the term "predetermined." GameTech also did not advocate this below.

[5] There is no merit to GameTech's argument that there are "independent, alternative grounds for affirming the decision below." Opp. 22. Neither court below ever ruled on GameTech's other theories. See Opp. 6, n. 3;

5. Where the Facts are in Dispute, Resolution of the Doctrine of Equivalents is a Jury Issue

With respect to the second question presented by the petition, GameTech contends that Planet Bingo somehow waived its jury argument because it did not raise it until its Petition for Rehearing below. Opp. 24. The cases cited by GameTech do not stand for the proposition that an argument concededly raised below in a petition for rehearing is waived. In any event, the essence of Planet Bingo's arguments against the vitiation doctrine – as to which GameTech makes no waiver argument – is that "a finding of 'vitiation' is only appropriate '[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent.'" Pet. 26 (quoting *Warner-Jenkinson*, 520 U.S. at 39 n. 8.) To the extent that GameTech is asserting that the precise phrasing of Planet Bingo's second question was different prior to the Petition for Rehearing stage below, that does not establish waiver. *See Nelson v. Adams USA, Inc.*, 529 U.S. 460, 469, 120 S.Ct. 1579, 1586 (2000).

It is not Planet Bingo's contention that "every case involving the doctrine of equivalents must go to a jury[,]" as GameTech asserts. Opp. 25.[6] However, before it may

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Opp. 22. Before this Court will consider alternative grounds to support a judgment, these must actually have supplied the basis for that decision. *See, e.g., Matsushita Elec. Indus. Co., Ltd. v. Epstein*, 516 U.S. 367, 379, 116 S.Ct. 873, 880 (1996). Also, having sought and obtained summary judgment, it is disingenuous for GameTech to now argue that the record below is somehow lacking in "any concrete detail." Opp. 23.

[6] Elsewhere, GameTech takes the opposite approach, and tries to find an admission that GameTech was entitled to summary judgment, based on Planet Bingo's effort to obtain summary judgment in its favor. Opp. 24. Clearly, a party can seek summary judgment based on an assertion that the evidence supporting *its* position is undisputed, while arguing that, at a minimum, it has at least succeeded in raising a disputed issue of fact

decide equivalence as a matter of law, the district judge must determine, based on a review of the "evidence," that "no reasonable jury could determine two elements to be equivalent." *Warner-Jenkinson, supra*. The jury may not be replaced by resort to a thesaurus. As GameTech's opposition makes clear, it believes that a "deliberate" inclusion of a claim element precludes an assertion of equivalence. The court below so held. If this is the law, the jury has in fact been ousted from the equivalence analysis.

CONCLUSION

For the foregoing reasons, and for the reasons stated in the petition for certiorari, the petition should be granted.

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precluding summary judgment in favor of its opponent. The district court's and Federal Circuit's clear statements regarding Rainbow Bingo's "predetermined winning combination" and "predetermined aspects," *supra*, reflect that Planet Bingo had a credible basis for such action.